IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: **PHILYAW, Jeffry Jovan**

Application Serial No.:   **09/642,891**   **Confirmation No.:**   **8887**

Filing Date: **August 21, 2000**

Group: **2161**

Examiner: **KANG, Paul H.**

Title: **RETRIEVING PERSONAL ACCOUNT INFORMATION FROM A WEB SITE BY READING A CREDIT CARD**

BRIEF ON APPEAL

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APPELLANTS' MAIN BRIEF ON APPEAL

This Brief is submitted in accordance with 37 C.F.R. § 41.67 concerning the Notice of Appeal filed May 14, 2007 in response to the Final Office Action dated February 14, 2007, wherein the Examiner finally rejected claims 1-12 that comprise all of the pending claims in this application.

I. Real Party Interest.

The party in interest is LV Partners, L.P., a Texas limited partnership, whose general partner is LV GP, L.L.C., and whose principal office and place of business is at 2626 Cole Avenue, Dallas, Texas 75204.

II. Related Appeals and Interferences.

Appellants have the following related application pending appeals:

- U.S. Patent Application Serial No. 07/614,937, Appeal No. 2007-1745, decided on December 11, 2007 (attached as Exhibit F) entitled "LAUNCHING A WEB SITE USING A PASSIVE TRANSPONDER" (Atty. Dkt. No. PHLY-25,356), filed on July 11, 2000;

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- U.S. Patent Application Serial No. 09/382,374 entitled "METHOD AND APPARATUS FOR ALLOWING A BROADCAST TO REMOTELY CONTROL A COMPUTER" (Atty. Dkt. No. PHLY-24,736), filed on August 24, 1999; and

- U.S. Patent Application Serial No. 09/602,034 entitled "CONTROLLING A PC USING A TONE FROM A CELLULAR TELEPHONE" (Atty. Dkt. No. PHLY-25,337), filed on June 23, 2000.

Appellants have filed Notices of Appeal in the following related applications:

- U.S. Patent Application Serial No. 09/382,426 entitled "METHOD AND APPARATUS FOR LINKING A WEB BROWSER TO A PROMOTIONAL OFFER" (Atty. Dkt. No. PHLY-24,732), filed on August 24, 1999; and

- U.S. Patent Application Serial No. 09/568,205 entitled "METHOD AND APPARATUS FOR UTILIZING A UNIQUE TRANSACTION CODE TO UPDATE A MAGAZINE SUBSCRIPTION OVER THE INTERNET" (Atty. Dkt. No. PHLY-24,914) filed on May 9, 2000.

The above-identified patent application has no related interferences.

III. Status of the Claims.

Claims 1 – 12 from the application are pending, stand firmly rejected, and are on appeal here. A complete and current listing of Claims 1 – 12 are attached here in the **CLAIMS APPENDIX**.

IV. Status of Amendments.

Appellants filed an Amendment and Response on November 20, 2006 in response to the Office Action, mailed May 18, 2006 which was entered; however, no amendments to the claims were presented. An amendment filed February 13, 2006 was the last Response entered that amended the Claims.

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V. Summary of the Claimed Subject Matter.

The present invention, as set forth currently in independent Claim 1, relates to a method of accessing personal account information of a credit card associated with a user over a global communication packet-switched network. The method comprises the step of, at a user location disposed on the network,[1] a machine-resolvable code (MRC) is resolved that has coded information contained therein which is disposed on the credit card of the user.[2] The coded information has no personal information contained therein relating to the user or routing information over a network.[3] The coded information, which is associated with routing information that is associated with both the personal account information of the user and a specific and unique credit card company server that has stored thereat the personal account information of the user, is extracted from the MRC.[4] In response to the steps of resolving and extracting, the routing information is obtained to the credit card server associated with the extracted coded information.[5] Then, the user location is connected to the specific and unique credit card company server across the network over a determined route in accordance with the obtained routing information.[6] The extracted coded information is transmitted to the specific and unique credit card company server over the determined route during the step of connecting.[7] The transmitted coded information is used at the specific and unique credit card company server to determine the personal account information associated with the extracted coded information.[8] The determined personal account information is returned from the specific and unique credit card

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[1] See Specification Figure 27; Figure 34; page 46, lines 20-22; page 47, lines 11-17; page 55, lines 24-27; and page 56, line 1.

[2] See Specification Reference # 2500 on Figure 25; Specification Reference # 3402 on Figure 34; page 45, lines 12-22; page 47, lines 1-3; page 47, lines 6-9; page 55, lines 2-5; page 55, lines 10-17; and page 55, lines 19-24.

[3] See Specification page 47, lines 17-27; page 48, lines 1-4; page 49, lines 3-8; page 50, lines 18-27; page 51, lines 1-7; page 53, lines 5-17; page 54, lines 1-27; page 55, lines 10-27; page 56, lines 1-27; page 57, lines 10-12; page 57, lines 19-26; page 58, lines 7-23; page 58, lines 24-27; page 59, lines 1-12; and page 64, lines 15-24.

[4] See Specification page 55, lines 10-27; page 56, lines 1-27; page 57, lines 10-12; page 57, lines 19-26; page 58, lines 7-23; page 58, lines 24-27; page 59, lines 1-12; and page 64, lines 15-24.

[5] See Specification page 55, lines 19-27; page 56, lines 1-27; page 57, lines 19-27; page 58, lines 1-6; page 58, lines 24-27; page 60, lines 1-18; page 61, lines 20-27; page 62, lines 5-23; page 63, lines 19-26; page 64, lines 1-7; and page 64, lines 15-24.

[6] See Specification page 56, lines 22-27; page 58, lines 4-6; page 59, lines 7-12; page 60, lines 19-24; page 61, lines 25-27; page 62, lines 20-27; page 63, lines 1-5; page 64, lines 6-7; and page 64, lines 22-24.

[7] See Specification page 56, lines 1-27; page 57, lines 4-18; page 58, lines 7-19; page 59, lines 7-12; page 60, lines 1-14; page 61, lines 25-27; page 62, lines 9-23; page 64, lines 1-7; page 64, lines 19-27; page 65, lines 1-27; and page 66, lines 1-9.

[8] See Specification page 56, lines 3-5; page 56, lines 22-27; page 57, lines 4-18; page 57, lines 25-27; page 58, lines 3-6; page 58, lines 16-23; page 59, lines 1-12; page 60, lines 5-14; page 62, lines 16-27; page 63, lines 5-11; page 64, lines 4-14; page 64, lines 22-24; page 65, lines 8-22; and page 66, lines 3-9.

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company server to the user location.[9] The determined personal account information is then presented to the user at the user location.[10]

The present invention, as set forth currently in dependent Claim 2, relates to the method of Claim 1, where the MRC is optical indicia.[11]

The present invention, as set forth currently in dependent Claim 3, relates to the method of Claim 2, where the optical indicia is a bar code.[12]

The present invention, as set forth currently in dependent Claim 4, relates to the method of Claim 1, where the routing information in the step of obtaining is stored on a user computer at the user location such that the coded information in the step of extracting is used to obtain the corresponding routing information from the user computer.[13]

The present invention, as set forth currently in dependent Claim 5, relates to the method of Claim 4, where the user computer stores a plurality of coded information each associated with unique routing information such that reading of the MRC of a select one of one or more credit cards of the user causes the user computer to connect to the corresponding specific and unique credit card company server over the network.[14]

The present invention, as set forth currently in dependent Claim 6, relates to the method of Claim 1, where the step of resolving utilizes a reading device which is a wireless scanner that transmits the coded information to a user computer at the user location via a receiving device operatively connected to the user computer.[15]

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[9] See Specification page 56, lines 3-5; page 56, lines 22-27; page 57, lines 4-18; page 57, lines 25-27; page 58, lines 3-6; page 58, lines 16-23; page 59, lines 1-12; page 60, lines 5-18; page 62, lines 16-27; page 63, lines 5-11; page 64, lines 6-10; page 64, lines 22-24; page 65, lines 19-22; and page 66, lines 3-6.
[10] See Specification page 56, lines 3-9; page 58, lines 16-23; page 59, lines 10-17; page 60, lines 5-14; page 63, lines 5-11; page 64, lines 10-12; page 65, lines 19-22; and page 66, lines 3-6.
[11] See Specification Reference # 3402 on Figure 34; page 55, lines 11-14; page 59, lines 21-23; page 73, lines 25-28; page 75, lines 12-16; and original Claim 2.
[12] See Specification Reference # 3402 on Figure 34; page 55, lines 11-14; page 59, lines 21-23; page 73, lines 25-28; page 75, lines 12-16; and original Claim 3.
[13] See Specification page 55, lines 19-24; and page 56, lines 14-27; page 58, lines 9-12; and original Claim 4.
[14] See Specification page 57, lines 1-18; and page 59, lines 24-27; page 60, lines 1-24; and page 61, lines 20-27; and original Claim 5.
[15] See Specification Reference #3410 on Figure 34; page 57, lines 19-25; and original Claim 6.

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The present invention, as set forth currently in dependent Claim 7, relates to the method of Claim 1, where personal account information in the step of presenting is displayed on a computer display operatively connected to a user computer at the user location.[16]

The present invention, as set forth currently in dependent Claim 8, relates to the method of Claim 1, where the routing information in the step of obtaining comprises a network address of the specific and unique credit card company server on the network and file path information which locates the personal account information of the user on the specific and unique credit card company server.[17]

The present invention, as set forth currently in independent Claim 9, relates to a method for accessing personal information from a remote location on a network. At a user location on the network,[18] a unique information access code that disposed on a portable access device that is carried by a user is read.[19] The unique information access code is uniquely associated with both routing information on the network to the remote location and with personal information at the remote location of a user that is associated with the portable access device.[20] The association of the remote location with the unique information access code is unique to such unique information access code such that only that single remote location contains the associated personal information.[21] Routing information is obtained from a database by comparing the unique information access code in a matching operation to a record in the database to determine if there exists in the record a pre-association between the unique information access code and at least one routing information.[22] If so, then access is allowed to such matching routing

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[16] See Specification Reference #1612 on Figure 16; page 56, lines 3-5; page 58, lines 16-19; page 59, lines 10-12; page 61, lines 9-11; page 63, lines 8-11; and page 64, lines 10-12.
[17] See Specification page 55, lines 19-27; page 56, lines 1-27; page 57, lines 25-27; page 58, lines 1-9; page 59, lines 1-10; page 60, lines 14-18; page 61, lines 20-27; page 62, lines 9-27; page 64, lines 4-10; and page 64, lines20-24.
[18] See Specification Figure 27; Figure 34; page 46, lines 20-22; page 47, lines 11-17; page 55, lines 24-27; and page 56, line 1.
[19] See Specification Reference # 2500 on Figure 25; Specification Reference # 3402 on Figure 34; page 45, lines 12-22; page 47, lines 1-3; page 47, lines 6-9; page 55, lines 2-5; and page 55, lines 10-17.
[20] See Specification page 55, lines 19-24; page 56, lines 1-27; page 57, lines 1-17; page 57, lines 24-28; page 58, lines 1-23; page 59, lines 1-12; page 62, lines 5-27; and page 64, lines 15-24.
[21] See Specification page 57, lines 1-17; page 57, lines 24-28; page 58, lines 1-23; page 59, lines 1-12; page 60, lines 19-24; page 61, lines 20-27; page 64, lines 1-10; page 64, lines 20-27; page 65, lines 1-27; and page 66, lines 1-6.
[22] See Specification page 56, lines 1-2; page 56, lines 22-27; page 57, lines 27-28; page 58, lines 1-6; page 61, lines 20-27; page 62, lines 9-14; page 64, lines 1-7; page 64, lines 19-20; page 65, lines 15-17; page 65, lines 26-27; page 66, lines 1-2; and page 67, lines 1-4.

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information.[23] A remote location is accessed in accordance with the obtained routing information.[24] The unique information access code is transmitted to the remote location.[25] The unique information access code is then received at the remote location, and personal information associated therewith is accessed and forwarded back to the user location for viewing by the user.[26] In forwarding the forwarded information, a request for personal identification is first sent from the remote location after it is determined that there is personal information associated with the unique information access code contained in the database local to the remote location.[27] Then, the personal identification information is entered at the user location.[28] In response to input of personal identification information by the user, the personal information is returned to the user location.[29]

The present invention, as set forth currently in dependent Claim 10, relates to the method of Claim 9, where the network is a global communication network.[30]

The present invention, as set forth currently in dependent Claim 11, relates to the method of Claim 9, where the portable access device comprises a card that is typically utilized for credit transactions.[31]

The present invention, as set forth currently in dependent Claim 12, relates to the method of Claim 9, where the steps of obtaining and accessing comprises the steps of first, in response to

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[23] See Specification page 56, lines 1-5; page 56, lines 22-27; page 57, lines 27-28; page 58, lines 1-6; page 61, lines 20-27; page 62, lines 1-4; page 62, lines 16-18; page 64, lines 4-7; page 64, lines 20-24; page 65, lines 18-22; page 66, lines 2-3; and page 67, lines 3-4.

[24] See Specification page 55, lines 24-27; page 56, lines 1-5; page 56, lines 22-27; page 58, lines 1-5; page 58, lines 9-19; page 59, lines 7-10; page 60, lines 1-18; page 61, lines 25-27; page 62, lines 18-23; page 63, lines 3-5; page 63, lines 17-26; page 64, lines 6-7; page 64, lines 22-24; page 65, lines 3-7; page 65, lines 9-19; and page 66, lines 1-3.

[25] See Specification page 56, lines 1-5; page 56, lines 22-27; page 58, lines 7-16; page 59, lines 1-4; page 62, lines 23-27; page 64, lines 1-7; page 64, lines 19-27; page 65, lines 1-27; and page 66, lines 1-9.

[26] See Specification page 56, lines 3-9; page 58, lines 7-19; page 59, lines 1-4; page 60, lines 5-14; page 62, lines 23-27; page 63, lines 5-11; page 64, lines 10-12; page 65, lines 19-22; and page 66, lines 3-6.

[27] See Specification page 58, lines 19-23; page 63, lines 8-12; page 64, lines 10-14, page 66, lines 7-8; and pag e68, lines 1-4.

[28] See Specification page 58, lines 19-23; page 61, lines 12-15; page 63, lines 8-12; page 64, lines 10-14, page 66, lines 7-9; and page 68, lines 1-2.

[29] See Specification page 58, lines 16-23; page 63, lines 8-12; page 64, lines 10-14, and page 66, lines 3-8.

[30] See Specification, Reference # 306 on Figure 34; page 15, lines 1-3; page 55, lines 24-27; page 56, lines 1-5; page 57, lines 4-7; page 58, lines 12-19; page 59, lines 7-10; page 59, lines 17-21; page 60, lines 11-14; page 60, lines 25-27; page 62,lines 1-4; page 63, lines 5-7; page 63, lines 14-26; page 64, lines 4-27; page 65, lines 3-7; page 67, lines 3-4; page 74, lines 25-27; page 75, lines 1-2; and page 76, lines 4-5.

[31] See Specification Reference # 2500 on Figure 25; Specification Reference # 3402 on Figure 34; page 45, lines 12-22; page 47, lines 1-3; page 47, lines 6-9; page 55, lines 2-5; and page 55, lines 10-17.

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the step of reading, accessing an intermediate location on the network remote from the user location.[32] Then, transmitting the unique information access code to the intermediate location from the user location.[33] The intermediate location has contained thereat the database with associations between a plurality of unique information access codes and associated unique routing information to associated remote locations on the network.[34] Then, comparing the received unique information access code with the stored unique information access codes. If a match is found, then returning the matched unique routing information to the user location.[35] Finally, utilizing the returned unique routing information from the intermediate location to access the remote location.[36]

VI. Grounds of Rejection to be Reviewed on Appeal.

Claims 1-5, and 7-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0016749 A1 to Borecki et al.("*Borecki*") in view of U.S. Patent No. 6,064,979 to Perkowski ("*Perkowski*"). Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Borecki-Perkowski*, as applied to Claims 1-5 and 7-12, and further in view of U.S. Patent No. 6,170,746 to Brook et al. ("*Brook*"). Claims 1 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Perkowski* in view of U.S. Patent No. 6,446,049 to Janning et al. ("*Janning*").

As detailed below, the Examiner has improperly applied the combination of *Borecki-Perkowski* to Claims 1-5 and 7-12; *Borecki-Perkowski-Brook* to Claim 6; and *Perkowski-Janning* to Claims 1 and 9. Specifically, Appellants submit that the §103 rejections based on the respective combinations are not proper and are without basis, and that the Examiner has failed to state a *prima facie* case as to the combination constituting a viable combination of references under 35 U.S.C. § 103.

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[32] See Specification page 63, lines 14-26; page 64, lines 17-19; and page 65, lines 1-3.
[33] See Specification page 64, lines 1-4; page 64, lines 16-20; and page 65, lines 9-17; page 65, lines 24-27 and page 66, lines 25-27.
[34] See Specification page 64, lines 1-7; page 64, lines 19-21; and page 65, lines 3-7; page 65, lines 15-19; and page 65, lines 26-27.
[35] See Specification page 64, lines 1-7; page 64, lines 19-21; and page 65, lines 3-7; page 65, lines 15-19; page 65, lines 26-27 and page 67, lines 1-3.
[36] See Specification page 64, lines 4-10; page 64, lines 19-24; and page 65, lines 3-7; page 65, lines 18-22; page 66, lines 2-9; page 67, lines 3-4; and page 67, lines 7-20.

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VII. Argument and Discussion.

In order to prevail, Appellants must show that the Examiner has improperly combined the references in support of the 35 U.S.C. § 103 rejection. As such, a brief discussion of the relevant rules and recent court decisions affecting a proper rejection under 35 U.S.C. § 103 follows.

A. Rejections under 35 U.S.C. §103

MPEP § 2142 specifies that:

> The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

In regard to what an examiner must show in order to establish a *prima facie* case of obviousness, MPEP § 2142 further explains that:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.... Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In regard to what an examiner must do in order to meet the first criterion for a prima facie rejection, MPEP § 2143.01 specifies that:

> Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

In the present application, the various combinations of references proposed by the Examiner are not supported by a proper suggestion or motivation to make each proposed modification. This means that the first criterion for a *prima facie* rejection has not been met, which in turn means the Examiner has failed to carry the burden of establishing a *prima facie* rejection. In addition, certain claim limitations are not taught or suggested by the cited

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combinations, which means that the third criterion for a *prima facie* rejection has not been met, and that the Examiner has further failed to carry the burden of establishing a *prima facie* rejection for this independent reason. Further, the Examiner has failed to put forth any arguments and has not provided any articulated reasoning as to how any deficiency (missing element) could be solved in a predictable manner through combination with any other reference.

B. Recent Decisions Affecting a Finding of Obviousness.

1. In re *Kahn*.

With respect to obviousness, a claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art."[37] Obviousness is a question of law, based upon underlying factual questions which are reviewed for clear error following a bench trial. These "underlying factual inquiries include: (1) The scope and content of the prior art; (2) The level of ordinary skill in the prior art; (3) The difference between the claimed invention and the prior art; and (4) Objective evidence of nonobviousness."[38]

In *Kahn* the Court noted that:

> ". . .to reject claims in an Application under § 103, an Examiner must show an unrebutted *prima facie* case of obviousness . . . on appeal to the board, an Applicant can overcome a rejection by showing insufficient evidence of a *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness."[39]

When combining references, it is well recognized that "[m]ost inventions arise from a combination of old elements and each element may often be found in the prior art."[40] "However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole."[41] *Kahn* further states:

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[37] 35 U.S.C. § 103(a) (2000); *In re Kahn*, 441 F.3d 977, 985 (Fed. Cir. 2006) (citing *Graham v. John Deere Co.*, 383 U.S.1, 13-14, 86 S.Ct. 684, 15L, Ed. 2d 545, 1962)
[38] *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999).
[39] *Kahn*, 441 F.3d at 985
[40] *In re Rouffett*, 149 F.3d 1350, 1357
[41] *Kahn*, 441 F.3d at 986, citing *Rouffett*, 149 F.3d at 1355, 1357

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Rather, to establish a *prima facie* case of obviousness based on a combination of elements disclosed in the prior art, the Board must articulate the basis on which it concludes that it would have been obvious to make the claimed invention. *Id.* In practice, this requires that the Board "explain the reasons one of the ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious." *Id. at 1357-59.* This entails consideration of both the "scope and content of the prior art" and the "level of ordinary skill in the pertinent art" aspects of the Graham test.[42]

The primary test that has been put forth by the Federal Circuit is the teaching-suggestion-motivation test. *Kahn* set forth that, when there is no explanation provided by the Board to explain the motivation, or the suggestion or the teaching, that would have led a skilled artisan at the time of the invention to the claimed combination as a whole, then the court would infer that hindsight was utilized to conclude that the invention was obvious. *Kahn* relied upon the *Rouffett* case for this teaching at 1358. The "teaching-suggestion-motivation" requirement was set forth to protect against the entry of hindsight into the obviousness analysis, a problem which §103 was meant to confront. Thus, in order to establish a *prima facie* case, some explanation as to teaching, suggestion, or motivation of each of the references and how they can be combined is required.

Although *Kahn* sets forth the teaching-suggestion-motivation test, there is still the "analogous-art" test that must be applied, this being one test that was articulated by the Supreme Court as part of the *Graham* analysis.[43] "The analogous-art test requires that the Board show a reference is either in the field of the Applicant's endeavor or is reasonably pertinent as to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection."[44] The following was further stated by *Kahn*:

> References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* ("It is necessary to consider the reality of the circumstances, in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor."

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[42] *Kahn,* 441 F.3d at 987
[43] See *Dann v. Johnston*, 425 U.S. at 219, 226, 96 S.Ct. 1393, 47 L.Ed 2d 692 (1976).
[44] *Kahn,* 441 F.3d at 987.

> (quoting *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979))). We have explained that this test begins the inquiry into whether a skilled artisan would have been motivated to combine references by defining the prior art relevant for the obviousness determination, and that it is meant to defend against hindsight. See *id.*; *In re Clay*, 996 F.2d 656, 659-60 (Fed. Cir. 1992).[45]

As such, the first step of analyzing the combination provided by the Examiner is to examine the references and determine if the combination satisfies the analogous-art test. The next step for determining obviousness is to analyze the teaching-suggestion-motivation test which:

> . . . picks up where the analogous art test leaves off and informs the Graham analysis. To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, [**23] or reasoned basis to explain why the conclusion of obviousness is correct. The requirement of such an explanation is consistent with governing obviousness law, see *§ 103(a)*; *Graham*, 383 U.S. at 35; *Dann*, 425 U.S. at 227-29, and helps ensure predictable patentability determinations.[46]

Even if all of the elements of a claim are disclosed in various prior art references, the long-standing rule that a claimed invention, as a whole[47], cannot be said to be obvious unless there is some reason or motivation given in prior art why someone would have been prompted to combine the teachings or the references.[48] The prior art itself may suggest desirability of a combination, or the motivation may come from other sources (for example, economic factors).[49] Thus, the motivation to combine the relevant art or teachings does not have to be found explicitly in the prior art but, rather, can be implicit thereto. "However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."[50][51]

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[45] *Id*

[46] *Id.*

[47] *In re Hiraro*, 535 F.2d, 67, (C.C.P.A. 1966).

[48] *In re Regel*, 526 F.2d, 1399 (C.C.P.A. 1975); *In re Bond*, 910 F.2d, 831, (Fed. Cir. 1990).

[49] See e.g. *In re Clinton*, 527 F.2d 1226 (C.C.P.A. 1976); *Cable Elec. Prods., Inc. v. Genmart, Inc.*, 77 F.2d, 1015 (Fed. Cir. 1985).

[50] *Kahn*, 441 F.3d at 998 referring to *Lee*, 277, F.3d at 1343-46 and *Rouffett*, 149 F.3d at 1355-59.

[51] It is noted that the Supreme Court in the recently decided case, *KSR International Co. v. Teleflex Inc, et al.*, 127 S. Ct. 1727 (2007) cited this specific language at page 1741 therein.

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The purpose of such requirement is to ensure "due process and non-arbitrary decision making", as it is in § 103.[52]

Kahn articulated the considerations for motivation when analyzing obviousness. The Court stated "the problem examined is not the specific problem solved by the invention, but the general problem that confronted the inventor before the invention was made."[53] In the reference in *Cross*, the quote that was cited by the Court[54] was that "one of ordinary skill in the art need not see the identical problem addressed in the prior art reference to be motivated to apply its teachings." As to motivation, the Courts upheld that the evidence of motivation to combine the prior art references "may flow from the prior art references themselves, knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved."[55] *Kahn* summarized the motivation-suggestion-teaching test as follows:

> Therefore, the "motivation-suggestion-teaching" test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. See *Cross Med. Prods.*, 424 F.3d at 1321-24. From this it may be determined whether [**26] the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art–i.e., the understandings and the knowledge of persons having ordinary skill in the art at the time of the invention–support the legal conclusions of obviousness. See *Princeton Biochemicals*, 411 F.3d at 1338 (pointing to evidence supplying detailed analysis of the prior art and the reasons one of ordinary skill would have possessed the knowledge and motivation to combine).[56]

In *Alza Corporation v. Mylan Laboratories, Inc.*, 464 F.3d 1286 (Fed. Cir. 2006), the Federal Circuit has responded to arguments made during pendency of the recently decided Supreme Court case, *KSR International Co v. Teleflex Inc, et al.*, 127 S. Ct. 1727 (2007), and has spelled out its law on obviousness, insisting that it is in harmony with Supreme Court precedent.

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[52] *Kahn*, 441 F.3d at 998 referring to *Lee*, 277, F.3d at 1343-46 and *Rouffett*, 149 F.3d at 1355-59.
[53] *Kahn*, 441 F.3d at 988, referring to *Cross Medical Products, Inc. v. Metronics Sofamore Danek, Inc.*, 424 F.3d 1293, 1323 (Fed. Cir. 2005).
[54] *Cross*, 424 F.3d at 1323.
[55] *Medichem S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir 2006), quoting *Brown and Williamson Tobacco Corp. v. Phillip Morris, Inc.*, 229 F.3d, 1120, 1125 (Fed. Cir. 2000).
[56] *Kahn*, 441 F.3d at 988.

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In the facts of this case, *Alza* sued Mylan for infringement of its patent (6,124,355) under 35 U.S.C. §271(e)(2) after Mylan sought FDA approval to market a generic version of oxybutynin, a drug used to treat urinary incontinence. The Federal Circuit affirmed the obviousness and non-infringement decisions of the district court.

In the process, Judge Arthur Gajarsa dedicated five pages of his opinion to then outline the Federal Circuit's law on obviousness, responding to many arguments made in the then pending Supreme Court case of *KSR Int'l Co. v. Teleflex, Inc.* (U.S. No. 04-1350). KSR and many amici, including the U.S. government, have challenged the Federal Circuit rule that proof of obviousness must include a showing of a "teaching, suggestion, or motivation" to combine the prior art elements of the claimed invention. *KSR* and others have said that this requirement is too rigid and is inconsistent with Supreme Court decisions issued since *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

Judge Gajarsa wrote the following in his *Alza* opinion:

> This requirement has been developed consistent with the Supreme Court's obviousness jurisprudence as expressed in *Graham* and the text of the obviousness statute that directs us to conduct the obviousness inquiry "at the time the invention was made" 35 U.S.C. §103. As we explained in [*In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006)],
>
> > The motivation-suggestion-teaching test picks up where the analogous art test leaves off and informs the *Graham* analysis. To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct. The requirement of such an explanation is consistent with governing obviousness law . . .
>
> 441 F.3d at 987. We further explained that the "motivation to combine" requirement "[e]ntails consideration of both the 'scope and content of the prior art' and 'level of ordinary skill in the pertinent art' aspects of the *Graham* test." *Id*. at 986.

At its core, our anti-hindsight jurisprudence is a test that rests on the unremarkable premise that legal determinations of obviousness, as with such determinations generally, should be based on evidence rather than on mere speculation or conjecture. Our court's analysis in *Kahn* bears repeating:

> A suggestion, teaching, or motivation to combine the relevant prior art teachings *does not have to be found explicitly in the prior art*, as "the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references.... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be *some* articulated reasoning with *some* rational underpinning to support the legal conclusion of obviousness. This requirement is as much rooted in the Administrative Procedure Act [for our review of Board determinations], which ensures due process and non-arbitrary decision making, as it is in § 103.

441 F.3d at 987-88 (quoting *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000)) (citations omitted) (emphases added). There is flexibility in our obviousness jurisprudence because a motivation may be found *implicitly* in the prior art. We do not have a rigid test that requires an actual teaching to combine before concluding that one of ordinary skill in the art would know to combine references. This approach, moreover, does not exist merely in theory but in practice, as well. Our recent decisions in *Kahn* and in [*Cross Med. Prods., Inc., v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293 (Fed. Cir. 2005)] amply illustrate the current state of this court's views.[57]

2. KSR

The recently issued Supreme Court Case in *KSR* held that the Federal Circuit's Teaching, Suggestion or Motivation (TSM) test to combine known elements in order to show that the combination is obvious is too rigid. The Court reinforced their position that analysis under *Graham* has been reaffirmed. The Court indicated that its holding was that a "patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men."[58] The Court stated that this was a "principal reason for

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[57] *Alza Corporation v. Mylan Laboratories, Inc.*, 464 F.3d 1286, 1290 (Fed. Cir. 2006).
[58] *KSR*, 127 S. Ct. 1727, 1739 (2007), Citing *Great Atlantic & Pacific Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950).

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declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."[59] The Court further went on to indicate that there were three cases that illustrated the application of this doctrine of predictability. The first case was *United States v. Adams*, 383 U.S. 39, 40 (1966). In discussing this case, the Court noted that it had "relied upon the corollary principal that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious."[60] In the second case, *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969), the Court reiterated "while the combination of old elements performed a useful function, it added nothing to the nature and quality of the radiant-heat burner already patented."[61] In the third case, *Sakraida v. AGPro, Inc.*, 425 U.S. 273 (1976), the Court stated that "when a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious."[62]

The Court summarized these three cases as follows:

> The principles underlying these cases are instructive when the question is whether a patent claiming the combination of elements of prior art is obvious. When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. *If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability.* For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* and *Anderson's-Black Rock* are illustrative-a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.[63] (Emphasis added.)

The Court recognized that following the above stated principals might involve more than "the simple substitution of one known element for another or the mere application of a known

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[59] *KSR*, 127 S. Ct. at 1739.
[60] *Id*. at page 1740.
[61] *Id*.
[62] *KSR*, 127 S. Ct at page 1740 Citing *Sakradia* at 282.
[63] *Id*.at page 1741.

technique to a piece of prior art ready for the improvement."[64] The Court noted that it might "be necessary for a Court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent that issued."[65] However, the Court also noted that the analysis should be "made explicit" citing *Kahn* wherein it stated that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reason with some rational underpinning to support the legal conclusion of obviousness."[66] The Court noted that, however, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ."[67]

Although the Court in this opinion rejected the rigidity of the TSM test, there was some reference to the decision in *Alza* wherein the Court noted the Federal Circuit's position that "there is flexibility in our obviousness jurisprudence because the motivation may be found *implicitly* in the prior art. We do not have a rigid test that requires an actual teaching to combine . . . ," citing *Alza*, 464 F.3d at 1291.[68] However, the Court also noted that the *Alza* decision was not before it and that, although they may describe an analysis more consistent with the Court's earlier precedent, the Court of Appeals would have to consider the current decision in view of its future cases.

C. 35 U.S.C § 103 Rejection in the Application on Appeal.

Summary of Rejection:

- Claims 1-5 and 7-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Borecki* in view of *Perkowski*.

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[64] *KSR*, 127 S. Ct. at page 1741.
[65] *Id*. at page 1741
[66] *Id*.
[67] *Id*..
[68] *Id*. at page 1743.

- Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Borecki-Perkowski* as applied to Claims 1-5 and 7-12, further in view of *Brook*.

- Claims 1 & 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of *Perkowski* in view of *Janning*.

Regarding Claims 1-5 and 7-12, the Examiner states in the Final Office Action dated October 5, 2006:[69]

> It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the automated data entry and data locating system, as taught by Perkowski, into the credit card account information retrieval system of Borecki, for the purpose of enhancing the user friendliness of the system by automating manual data entry and automatically retrieving credit card information.

Regarding Claim 6, the Examiner states in the Final Office Action dated October 5, 2006:[70]

> As to claim 6, Borecki-Perkowski teach *(sic)* the invention substantially as claimed. However, Borecki-Perkowski does not explicitly teach a wireless scanner. In the same field of endeavor, Brook teaches a wireless barcode scanner (Brook, figure 1 and col. 3, line 6 - col. 4, line 4 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the wireless barcode scanner, as taught by Brook, into the system of Borecki-Perkowski, for the purpose of increasing user convenience and mobility.

Regarding Claims 1 and 9, the Examiner states in the Final Office Action dated October 5, 2006:[71]

> It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the credit card access system of Janning into the automated information access system of Perkowski for the purpose of easily and efficiently obtaining user's credit information while maintaining anonymity as well as convenience.

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[69] See Final Office Action dated October 5, 2006, at page 4.
[70] See Final Office Action dated October 5, 2006, at page 4.
[71] See Final Office Action dated October 5, 2006, at page 4.

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The Examiner stated in the Final Office Action dated February 14, 2007:

As to claim 1, Borecki teaches the invention substantially as claimed. Borecki teaches a system and method of accessing personal account information of a credit card associated with a user over a global communication packet-switched network, comprising the steps of:

connecting a user location to the specific and unique credit card company server across the network in accordance with a known URL (Borecki, Figure 2A and page 2, paragraph 0034-0035);

transmitting the account information to the specific and unique credit card company server over the network (Borecki, Figure 2A and page 2, paragraph 0034-0035 and page 3, paragraph 0039);

using customer account information at the specific and unique credit card company server to determine the personal account information associated with the customer account information from the credit card company server, to the user location (Borecki, page 3, paragraph 0040); and

presenting the information to the user at the user location (Borecki, page 2, paragraph 0034-0035 and page 3, paragraph 0040).

However, Borecki does not explicitly teach automating the steps of accessing said credit card company server. Specifically, Borecki does not explicitly teach:

at a user location disposed on the network, resolving a machine-resolvable code (MRC) having coded information contained therein and disposed on the credit card of the user, the coded information having no personal information contained therein relating to the user or routing information over a network;

extracting coded information from the MRC, the coded information associated with routing information that is associated with both the personal account information of the user and a credit card company server;

in response to the steps of resolving and extracting, obtaining the routing information to the credit card server associated with the extracted coded information;

connecting the user location to the credit card company server across the network over a determined route in accordance with the routing information.

In the same field of endeavor, Perkowski teaches a system and method for automatically retrieving information related to a commercial product by scanning an MRC, the coded information having no personal information contained therein relating to the user or routing information over a network (Perkowski, col. 3, line 63 - col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 38-40).

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Perkowski teaches at a user location disposed on the network, reading a machine-resolvable code (MRC) disposed on a commercial product of a user with a reading device (Perkowski, col. 3, line 63 - col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 38-40);

extracting coded information from the MRC, the coded information associated with routing information that corresponds to the commercial product information stored on a company server disposed on the network (Perkowski, col. 19, lines 12-55);

in response to the steps of reading and extracting, obtaining the routing information associated with the extracted coded information (Perkowski, col. 19, lines 12-55);

connecting the user location to the company server across the network over a determined route in accordance with the routing information (Perkowski, col. 19, lines 12-55).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the automated data entry and data locating system, as taught by Perkowski, into the credit card account information retrieval system of Borecki, for the purpose of enhancing the user friendliness of the system by automating manual data entry and automatically retrieving credit card information.[72]

Appellants submit the Examiner has simply broken Appellants' invention into its component parts and then attempted to find a prior art reference corresponding to each component to support an obviousness rejection under 35 U.S.C. § 103. In order to establish a *prima facie* case of obviousness using the combination of the respective references, the Examiner must first show that each of the references is analogous prior art and then provide an explanation as to whether the overall disclosures of the references, the teachings therein and the suggestions associated therewith, in addition to the level of skill in the art, support a conclusion of obviousness as it relates to the entire invention. The combination of these references as applied to the Claims is conclusory, and that no articulated reasoning with some rational underpinning to support the combination has been provided. Further, Appellants submit that support for the combination is based on hindsight and that the combination is improper.

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[72] See Final Office Action dated October 5, 2006, at pages 2-4

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1. Independent Claim 1 as rejected by the combination of *Borecki-Perkowski*.

In the Final Office Action mailed February 14, 2007, the Examiner maintains the 35 U.S.C. § 103 rejection of Claims 1-5 and 7-12. On page 2 of the Final Office Action the Examiner states:

> As to claim 1, Borecki teaches the invention substantially as claimed. Borecki teaches a system and method of accessing personal account information of a credit card associated with a user over a global communication packet-switched network, comprising the steps of:
>
> connecting a user location to the specific and unique credit card company server across the network in accordance with a known URL (Borecki, Figure 2A and page 2, paragraph 0034-0035);
>
> transmitting the account information to the specific and unique credit card company server over the network (Borecki, Figure 2A and page 2, paragraph 0034-0035 and page 3, paragraph 0039);
>
> using customer account information at the specific and unique credit card company server to determine the personal account information associated with the customer account information from the credit card company server, to the user location (Borecki, page 3, paragraph 0040); and
>
> presenting the information to the user at the user location (Borecki, page 2, paragraph 0034-0035 and page 3, paragraph 0040).[73]

The Examiner further states that ". . . Borecki does not explicitly teach automating the steps of accessing said credit card company server," and then provides *Perkowski* to cure the deficiency and states "[it] would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the automated data entry and data locating system, as taught by Perkowski, into the credit card account information retrieval system of Borecki, for the purpose of enhancing the user friendliness of the system by automating manual data entry and automatically retrieving credit card information."

2. The Cited References – Teaching/Suggestion/Motivation Test.

The process for determining obviousness is to analyze under the teaching-suggestion-motivation test. As previously discussed, the recent *KSR* Supreme Court case indicated that the Teaching-Suggestion-Motivation (TSM) test is not a rigid test; however, it is still considered to

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[73] See Final Office Action, mailed February 14, 2007, pages 2-3.

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be a factor. Under this test, each of the references must contain some type of teaching, as well as some type of suggestion, to allow for the combination. One also must be motivated to combine the references. If this test alone were utilized, the questions that must be answered are whether *Borecki* and *Perkowski* contain any teaching that would suggest to one skilled in the art to combine these two references to overcome the problem addressed by the present application, and whether any motivation to so combine exists. In the Response dated November 20, 2006, to the Office Action dated May 18, 2006, the arguments thereof repeated herein, Appellants question whether the cited references contain a teaching that would suggest the combination provided by the Examiner. The Examiner provided *Perkowski* to cure the deficiencies in *Borecki* regarding the automating the steps of accessing said credit card company server.

a. Discussion of U.S. Patent Publication No. 2002/0016749 to *Borecki et al.*

The primary reference the Examiner has cited is the *Borecki* reference. The primary purpose of *Borecki* is to provide private and secure electronic purchasing via the Internet.[74] *Borecki* provides a central server (12) configured with merchant databases and various modules to provide private and secure purchasing for registered users.[75] The modules include a pricing module (24), a digital checkbook module (28), a temporary card numbers module (30), an account cross-referencing module (32) and an omnibus accounting module 34.[76] The database includes a merchant database and, optionally in a database unit (36), a customer database, an IDs and password database, a customer balance database, a customer history database, a card number database, and a pricing database.[77]

A user computer (40) can connect to the central computer system (12) through the Internet (42).[78] The user initially signs up for the service through a sign-up process. The user selects a User ID and a password. Then, after filling out the application either online or off-line, the user selects a funding option of either debit from a personal checking account or a charge to a

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[74] See *Borecki*, Abstract.
[75] See *Borecki*, page 2, paragraphs 0030 and 0031.
[76] See *Borecki*, page 2, paragraph 0030.
[77] See *Borecki*, page 2, paragraph 0030.
[78] See *Borecki*, Figure 1; page 2, paragraph 0031.

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credit card account. The *Borecki* system provides the user an account number and member number. The user may then fund the account.[79]

Once registered, the user accesses the Internet and chooses to connect to the central computer system by entering the central computer system URL (i.e., http://www.Interchecks.com).[80] The user signs-on to the central computer system and activates their digital checkbook by entering a member number. The central computer system determines if the member number is valid. If the member number is valid, the central computer system prompts the user to enter their User ID and password. If the correct User ID and password are entered, the system grants the user access.[81] Thereafter, the user can request and obtain account information or request that the system display the user's digital checkbook with account information. When the user opens the checkbook, the system issues the user temporary debit card numbers and temporary credit card numbers.[82] The digital checkbook is a register of the member's account. When the user seeks to make internet purchases and opens the digital checkbook, the system finds a series of card numbers that are not in use and have never been assigned to that user and, using those numbers, assigns a temporary debit card number and a temporary credit account number to the user.[83] The temporary card numbers are linked to the user account and are active for a predetermined period of time. User account information, such as account balance and card numbers, is placed on the user computer in the form of an output identification file.[84]

The user may access various merchant sites to make purchases using the *Borecki* system. If the merchant is partnered with the private and secure purchasing system (i.e., the *Borecki* system), the user may select an icon on the merchant site to provide payment for products selected for purchase on the merchant site. In such case, the transactions are treated as debit card transactions. However, if the merchant is not partnered with the private and secure purchasing system, the user provides the temporary credit card numbers to provide payment for the products selected for purchase on the merchant site. In this case, information is routed through a bank

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[79] See *Borecki*, page 2, paragraph 0036.
[80] See *Borecki*, Figure 2A; page 2, paragraph 0034.
[81] See *Borecki*, page 3, paragraph 0039.
[82] See *Borecki*, page 2, paragraph 0035.
[83] See *Borecki*, page 3, paragraph 0041.
[84] See *Borecki*, page 3, paragraph 0042.

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card processor. The bank card processor transmits an approval or denial of the purchase. If the transaction is approved by the bank card processor, funds are transferred to the merchant processor. As such, this transaction is treated as a credit card transaction.[85]

Independent claim 1 recites a method of accessing personal account information of a credit card associated with a user over a global communication packet-switched network, comprising the steps of: at a user location disposed on the network, resolving a machine-resolvable code (MRC) having coded information contained therein and disposed on the credit card of the user, the coded information having no personal information contained therein relating to the user or routing information over a network; extracting the coded information from the MRC, the coded information associated with routing information that is associated with both the personal account information of the user and a specific and unique credit card company server having stored thereat the personal account information of the user; in response to the steps of resolving and extracting, obtaining the routing information to the credit card server associated with the extracted coded information; connecting the user location to the specific and unique credit card company server across the network over a determined route in accordance with the obtained routing information.

Appellants submit that *Borecki* does not disclose, or contemplate, resolving an MRC to extract coded information associated with routing information that is associated with both the personal account information of the user and a specific and unique credit card company server. The Examiner concedes that the primary citation to *Borecki* does not disclose, at a user location disposed on the network, resolving a machine-resolvable code (MRC) having coded information contained therein and disposed on the credit card of the user. The Examiner states:

> However, Borecki does not explicitly teach automating the steps of accessing said credit card company server. Specifically, Borecki does not explicitly teach:
> at a user location disposed on the network, resolving a machine-resolvable code (MRC) having coded information contained therein and disposed on the credit card of the user, the coded information having no personal information contained therein relating to the user or routing information over a network;

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[85] See *Borecki*, page 2, paragraph 0032.

extracting coded information from the MRC, the coded information associated with routing information that is associated with both the personal account information of the user and a credit card company server;

in response to the steps of resolving and extracting, obtaining the routing information to the credit card server associated with the extracted coded information;

connecting the user location to the credit card company server across the network over a determined route in accordance with the routing information.[86]

Nonetheless, the Examiner rejects Independent Claim 1 stating that *"Borecki* teaches the invention substantially as claimed"* and contending that the secondary citation to *Perkowski* provides this necessary disclosure. This contention is respectfully traversed as discussed with respect the combination of *Borecki* and *Perkowski* herein below.

Further, Independent Claim 1 recites connecting the user location to the specific and unique credit card company server across the network over a determined route in accordance with the obtained routing information. The Examiner states *Borecki* discloses "connecting a user location to the specific and unique credit card company server across the network in accordance with a known URL (Borecki, Figure 2A and page 2, paragraph 0034-0035)."[87] The relevant portion of *Borecki* states:

FIG. 2A is a flowchart 70 which diagrams procedures executed by and implemented in central computer system 12 of system 10 (shown in FIG. 1). After a user initiates 72 Internet access, *they choose to connect 74 to the private and secure purchases provider web site.* The user may choose to exit 76 at this time. Alternatively, if the user chooses to continue, they are queried 78 if they are accessing central computer system 12 for the first time. *If the user is accessing for the first time, a sign up process is initiated* 80 which is described in further detail in FIG. 2B below. If not accessing for the first time, the user establishes 82 a secure connection to the private and secure purchases provider web site, and enters 84 their digital checkbook, which is described in further detail in FIG. 2C below.

The user then chooses whether to request and obtain 86 account information or to display 88 their checkbook with account information. After account information is requested and obtained

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[86] See Final Office Action mailed February 14, 2007, page 3.
[87] See Final Office Action mailed February 14, 2007, page 2.

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86, the checkbook with account information is displayed 88. After display 88 of checkbook with account information, the user opens the checkbook and is issued 90 secure temporary card numbers, both debit and credit, for Internet purchases, which are described in further detail in FIG. 2E below. After temporary card numbers are issued 90, the user chooses 92 whether or not to make purchases via the Internet. The user exits 94 if no purchasing is to be done at this time. Internet purchasing is further described in FIG. 2F below.[88] *(emphasis added)*

Appellants previously stated "the user initiates an Internet access and then may choose to connect to a private and secure purchase provider web site."[89] In Figure 2A, *Borecki* illustrates that the customer initiates a communication link via direct access to the Internet to connect to a URL, i.e., http://InterChecks.com. *Borecki* expressly teaches that the user establishes a connection to the private and secure purchases provider web site prior to inputting any user account information.

Next, Independent Claim 1 recites "transmitting the extracted coded information to the specific and unique credit card company server over the determined route during the step of connecting." The Examiner again cites *Borecki*, Figure 2A and page 2, paragraphs 0034-0035 with page 3, paragraph 0039, for this teaching. The additional paragraph in *Borecki* states:

> FIG. 2C is a flowchart 140 which further illustrates of a process where a *user signs on and activates* their digital checkbook. A user signs on by *entering 142 their private and secure purchasing provider member number*. If the entered membership number is valid 144, the user is instructed to enter 146 their user ID and password. If the user ID is valid 148, access is granted 150. User IDs and membership numbers are provided in a database 152, which is part of database 36 (shown in FIG. 1). If an invalid member number is entered, and the number of attempts to enter the digital checkbook is below 154 a threshold, the user may retry 156 entering the digital checkbook, otherwise central computer system 12 (shown in FIG. 1), disconnects the user, forcing an exit 158. If a membership number entered 142 is valid 144, but the user ID entered 146 is not valid 148, an E-mail

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[88] See *Borecki*, page 2, paragraphs 0034-0035.
[89] See Response dated February 13, 2006, page 7.

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notification is sent 160 to the account holder of record, and central computer system 12 exits 162.[90] *(emphasis added)*

Borecki teaches that a user enters their member number, and if valid, the system prompts the user for their User ID and password. Therefore, *Borecki* requires a member number, a User ID, and a password to be entered at a user location in order to gain access to the private and secure purchase provider. As Appellants previously stated "[therefore,] the information that is provided by the user is merely that for accessing the private and secure purchases provider web site."[91] As such, *Borecki* expressly teaches 3 pieces of information (the member number, User ID and password) are *entered after* the user accesses the private and secure purchase provider site whose location was accessed by a known URL. However, *Borecki* does not disclose that this information is transmitted during the step of connecting.

Further, the Examiner mischaracterizes this element of the claim by changing the term "transmitting the extracted coded information" to "transmitting the account information." Appellants do not dispute that the information the user enters to sign-on to the private and secure purchase provider in *Borecki* is a member number, User ID and password, which can be interpreted as account information. However, Independent Claim 1 of the instant application recites that the extracted coded information that is transmitted is associated with routing information associated with *both* the personal account information and the specific and unique credit card company server. *Borecki* does not teach coded information, or any information, that is associated with routing information associated with both the personal account information and the specific server. Clearly, *Borecki* teaches away from the concept of a single code associated with routing information associated with both personal account information and the specific and unique server, as Borecki teaches there must be at least a URL, a member number, a User ID and a password separately. As such, *Borecki* also fails to teach the transmission of such coded information. Thus, *Borecki* cannot reasonably be interpreted to disclose the aforementioned feature of Independent Claim 1.

After transmitting the extracted coded information to the specific and unique credit card company server, Independent Claim 1 recites "using the transmitted coded information at the specific and unique credit card company server to determine the personal account information

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[90] See *Borecki*, page 3, paragraph 0039.
[91] See Response dated February 13, 2006, page 8.

associated with the extracted coded information." The Examiner cites *Borecki*, page 3, paragraph 0040 for this teaching stating:

> using customer account information at the specific and unique credit card company server to determine the personal account information associated with the customer account information from the credit card company server, to the user location (Borecki, page 3, paragraph 0040).[92]

As Appellants previously stated "there is some association someplace between the user password and the personal account encoded information, as this is what allows the user to enter their digital checkbook ... [thereafter] as set forth in blocks 84 and 86 of Fig. 2a, the program will flow to a block wherein the customer account information *can be requested and obtained*."[93] *Borecki* expressly teaches a method and means whereby a central server, after a user entering sign-on information, provides the user *access* to their account. The server determines personal account information only after the user enters, separately, a specific URL to connect to the server, a member number to be validated by the server, a User ID and a password. *Borecki* does not teach or contemplate using, at the specific and unique server, the same coded information that provided routing information to the specific and unique server in order to access personal account information. Thus, *Borecki* cannot reasonably be interpreted to disclose the aforementioned feature of Independent Claim 1.

The Examiner provides *Borecki*, paragraphs 0034, 0035 and 0040, to teach "returning the determined personal account information from the specific and unique credit card company server to the user location; and presenting the determined personal account information to the user at the user location" as recited by Independent Claim 1.[94]

Thus, to apply *Borecki* for the purpose of obviating Claim 1 in the present application, the Examiner must show that *Borecki* contains a teaching, suggestion, or motivation to solve the problem solved by Appellants' present claims. *Borecki* must also suggest that, at the time of the invention, a problem existed that could be solved by incorporating a Machine Resolvable Code (MRC) on a credit card of a user in order to extract coded information from the MRC such that the coded information is associated with routing information associated with both personal

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[92] See Final Office Action, mailed February 14, 2007, pages 2-3.
[93] See Response dated February 13, 2006, page 8.
[94] See Final Office Action, mailed February 14, 2007, pages 2-3.

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account information and the specific and unique credit card location. *Borecki* does not contain any such teaching, suggestion or motivation.

b. Discussion of U.S. Patent No. 6,064,979 to *Perkowski.*

The Examiner has provided *Perkowski* to cure the deficiencies in *Borecki*. Specifically, the Examiner has relied on *Perkowski*, "[to teach] a system and method for automatically retrieving information related to a commercial product by scanning an MRC, the coded information having no personal information contained therein relating to the user or routing information over a network."[95] The Examiner further states:

> In the same field of endeavor, Perkowski teaches a system and method for automatically retrieving information related to a commercial product by scanning an MRC, the coded information having no personal information contained therein relating to the user or routing information over a network (Perkowski, col. 3, line 63 - col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 38-40).
>
> Perkowski teaches at a user location disposed on the network, reading a machine resolvable code (MRC) disposed on a commercial product of a user with a reading device (Perkowski, col. 3, line 63 - col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 38-40);
>
> extracting coded information from the MRC, the coded information associated with routing information that corresponds to the commercial product information stored on a company server disposed on the network (Perkowski, col. 19, lines 12-55);
>
> in response to the steps of reading and extracting, obtaining the routing information associated with the extracted coded information (Perkowski, col. 19, lines 12-55);
>
> connecting the user location to the company server across the network over a determined route in accordance with the routing information (Perkowski, col. 19, lines 12-55).[96]

Perkowski provides a method and system for finding and serving consumer product-related information on the Internet.[97] *Perkowski* is directed towards the concept of providing an interface to a user to allow that user to search information regarding either a product having an associated Universal Product Code (UPC) or Universal Product Number (UPN) or information regarding products associated with the trademark (noting this association is not disclosed as

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[95] See Final Office Action mailed February 14, 2007, page 3.
[96] See Final Office Action mailed February 14, 2007, page 4
[97] See *Perkowski*, Abstract.

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being on a product or brochure).[98] *Perkowski* provides two methods of operation.[99] Each of these systems utilizes a browser programmed as the GUI-based interface for the user. The two independent modes of operation are the "Internet Product Service Information (IPSI) Find Mode" and the "UPSN Search Mode" system.[100] The user may be provided with an icon on their local internet browser.[101] Alternatively, the user selects an icon within an internet browser on their computer.[102] Upon selection of the icon, the user is connected through the internet to the IPSI Web-site.[103] The web-site may be accessed by a known URL, such as http://www.ipsi.com.[104] Regardless of whether the user is required to access the IPSI web-site first or is provided an icon on their browser, the user must select the IPSI finder button to initiate the functionality of the *Perkowski* system.[105] Selecting the IPSI finder button transmits entered UPC information to the IPSI server located on the internet.[106] When selecting the IPSI finder button, the user enters the product UPC information.[107] The UPC is encoded with a 12 digit number representing a manufacturer (first 6 digits), product (next 5 digits), and a check digit. The 12 digit, human readable number, is printed on the bottom of the UPC.[108] A user may manually enter a registered product's UPN (e.g., the UPC 12 digit numerical string) into a dialogue box of an Internet browser or Internet application tool.[109] The user may also scan the UPSN (Universal Product / Service Number – i.e., UPC) with a bar code symbol scanner.[110] Regardless of the method of entry of the UPC, the system (i.e, the IPSI server) performs a query based upon the UPC to determine if a corresponding URL for the product/manufacturer exists in

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[98] See *Perkowski*, Col 3, lines 55-67; and Col. 4, lines 1-14.
[99] See *Perkowski*, Col 3, lines 55-67; and Col. 4, lines 1-14.
[100] See Perkowski, starting at Col 18, line 55 in the section entitled "Operation of the IPSI Finding System and Method."
[101] See *Perkowski*, Col 8, lines 25-36.
[102] See *Perkowski*, Col 8, lines 37-45.
[103] See *Perkowski*, Col 8, lines 45-55.
[104] See *Perkowski*, Col 8, lines 55-60.
[105] See *Perkowski*, Col 8, lines 64-67; Col. 15, lines 53-60.
[106] See *Perkowski*, Col 8, lines 39-55; Col. 15, lines 55-59.
[107] See *Perkowski*, Col 15, lines 55-59.
[108] See *Perkowski*, Col 12, lines 3-19.
[109] See *Perkowski*, Col 19, lines 23-28.
[110] See *Perkowski*, Col 19, lines 38-40.

an IPSI Registrant Database.[111] If so, the URL, or list of URL's is provided to the user.[112] Thereafter, the user selects a URL corresponding to a web-site the user desires to access.[113]

The Examiner provides *Perkowski* to teach "at a user location disposed on the network, resolving a machine-resolvable code (MRC) having coded information contained therein and disposed on the credit card of the user, the coded information having no personal information contained therein relating to the user or routing information over a network; and extracting the coded information from the MRC, the coded information associated with routing information that is associated with both the personal account information of the user and a specific and unique credit card company server having stored thereat the personal account information of the user" as recited by Independent Claim1. Appellants agree that *Perkowski* teaches the concept of extracting coded information from the MRC wherein this coded information is associated with routing information that corresponds to the commercial product information stored on a company's server.[114] However, *Perkowski* contains no disclosure that the extracted information corresponds to routing information associated with both personal account information and the specific and unique server. *Perkowski* teaches that the information extracted from the UPC is a 12 digit number. This 12 digit number is associated with a specific URL or series of URL's only. As such, *Perkowski* merely provides a translation table that provides a relationship between an arbitrary code and a location on the network. The aforementioned feature of Independent Claim 1 recites that the extracted coded information corresponds to routing information that is associated to a particular piece of information (personal account information) *and* a particular server on the network (the specific and unique credit card server). Thus, *Perkowski* does not provide a disclosure that remedies the aforementioned, conceded deficiency in the primary citation to *Borecki*.

Further, Independent Claim 1 of the instant application recites "in response to the steps of resolving and extracting, obtaining the routing information to the credit card server associated with the extracted coded information." The Examiner contends that *Perkowski* teaches this feature of Independent Claim 1 of the instant application. The relevant portion of *Perkowski* states:

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[111] See *Perkowski*, Col 15, lines 60-67.
[112] See *Perkowski*, Col 15, lines 60-67; and Col. 19, lines 41-44.
[113] See *Perkowski*, Col 19, lines 45-55.
[114] See Response dated February 13, 2006, page 9.

When the system is in this operational mode, as illustrated in FIGS. 3A, 4A and 5A, 6A, a Web-based information resource pertaining to any commercial product or service registered with the system can be displayed and selected by the user in order to automatically access the same from the Internet. Such information resources can include advertisements, specifications, operation descriptions, product simulations, purchase information, maintenance information, warranty and servicing information, product updates, distributor information, incentives (e.g. discounts, rebates, coupons, etc.), electronic data transaction screens, etc. In this mode, desired product or service information is obtained by simply manually entering the registered product's UPN (e.g. its UPC's 12 digit numerical string) or the registered service's USN (e.g. its UPC's 12 digit numerical string) into the dialogue box of the Internet browser or Internet application tool. When using the seeded IPSI Database described hereinabove, only the first six digits of the UPC number need be entered into the dialogue box. An exemplary display screen produced from the IPSD Server might be as follows:

"Simply enter the 12 digit UPC the particular product; click REQUEST, and then wait for the display of the list of Web locators (URLs) at which the desired product information can be found on the Internet."

Alternatively, a bar code symbol scanner can be *used to enter the UPSN (e.g. UPC or USC number) into the system, thereby avoiding manual keyboard entry operations*.

In response to such data entry operations, a list of URLs organized according to the information subfield classifications set forth in FIG. 2A2 are displayed on Client System C_a making the request of the IPSD Server. At this stage, another display screen would appear with an exemplary message as follows:

"Please select the URL from the displayed URL list using the information subfield product information category displayed above. This will connect you to the product information related to the selected URL. You can return to the URL display list at anytime."

Upon selecting a particular URL from the displayed URL list, video and audio information content are automatically displayed on the Client System from the IPSI Server hosting the selected URL.[115] *(emphasis added)*

However, Perkowski expressly teaches the operation of the IPSI server in response to the entering of UPC information is as follows:

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[115] See *Perkowski*, Col. 19, lines 12-55.

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In order to enter the IPSI Finder mode of the system, *the user selects the "IPSI Finder" button* on the GUI-based browser display screen. Then at Block A of FIG. 6A, a UPSN is provided as input to IPSD Server S_b, and in response thereto the Client System C_a requests the IPSD Server S_b to provide each registered URL_i stored in the IPSI Registrant Database.

At Block B in FIG. 6A, the IPSD Server S_b *analyses the IPSI Registrant Database shown in FIG. 2A1 to determine whether or not a symbolically linked URL_i has been registered with $UPSN_i$ that has been provided as input.* If so, then in response to a URL selection *query based on the contents* of the information subfields shown in FIG. 2A2 and displayed on the screen of the Client System C_a, the IPSD Server S_b sends to the IPSI Server S_c hosting the user-selected URL_i, a request for the IPSI Server S_c to send product or service information at the selected URL_i to the requesting Client System C_a. If the IPSD Server S_b determines that there does not exist a URL_i in the IPSI Registrant Database symbolically linked with the $UPSN_i$ provided as input to the Client System C_a, then the IPSD Server S_b records the URL-request in the Non-IPSI Registrant Database for future registration operations with the company related to the input $UPSN_i$.

At Block C in FIG. 6A, the IPSI Server S_c receives the user-selected URL_i sent from the IPSD Server S_b and then provides to the Client System C_a, the product or service information located by the registered URL_i. Having accessed and displayed such product or service related information at the Client System, the user can review the information at the selected URL_i, acquire knowledge about the product or service, and may, if the option is provided at the URL-specified Web-site, purchase the product or service by way of an on-screen electronic commercial transaction.[116] *(emphasis added)*

Clearly, *Perkowski* teaches that the user must not only enter the UPC, manually or by scan operation, but must also select the IPSI Finder button. *Perkowski* explicitly teaches that scanning the UPC merely enters the 12 digit number into the browser. Further, as a result of the user selecting the IPSI Finder button and entering the UPC, the user makes a request of the Internet Product and Service Directory (IPSD) server to query the IPSI Registrant Database to determine if a URL has been registered with the UPC that has been entered. If the IPSD server finds a registered URL containing the UPC, the URL, or a list of URLs if more than one URL is registered with the UPC, is returned to the user. As Appellants previously stated "*Perkowski* merely provides a translation database that provides the relationship between an arbitrary code

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[116] See *Perkowski*, Col. 15, lines 53-67; and Col. 16, lines 1-18.

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and a location on the network."[117] As such, routing information is returned, not in response to resolving and extracting, but in response to the user initiating a request for the URL. Thus, *Perkowski* does not provide a disclosure that remedies the aforementioned, conceded deficiency in the primary citation to *Borecki*.

Additionally, Independent Claim 1 of the instant application recites "connecting the user location to the specific and unique credit card company server across the network over a determined route in accordance with the obtained routing information." The Examiner, though stating that Borecki both does not teach this feature and teaches this feature at page 2, paragraphs 0034-0035,[118] again cites *Perkowski*, column 19, lines 12-55 to provide this teaching. However, *Perkowski* explicitly teaches that the user is provided a list of URLs. Thereafter, the user selects a URL for connection to a location containing product information. The relevant portion of Perkowski, contained within the portion cited by the Examiner, states:

> In response to such data entry operations, a list of URLs organized according to the information subfield classifications set forth in FIG. 2A2 are displayed on Client System C_a making the request of the IPSD Server. At this stage, another display screen would appear with an exemplary message as follows:
> "Please select the URL from the displayed URL list using the information subfield product information category displayed above. This will connect you to the product information related to the selected URL. You can return to the URL display list at anytime."
> *Upon selecting a particular URL from the displayed URL list*, video and audio information content are automatically displayed on the Client System from the IPSI Server hosting the selected URL.[119] *(emphasis added)*

Therefore, Perkowski teaches that the user establishes a connection to the location containing product information. Perkowski teaches, and is limited to teaching, entering a UPC number, either manually or by scanning operation, to obtain a URL that the user may select in order to access a website containing information about a product related to the UPC. As such, *Perkowski* does not provide a disclosure that remedies the aforementioned, conceded deficiency in the primary citation to *Borecki*.

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[117] See Response dated February 13, 2006, page 9.
[118] See Final Office mailed February 14, 2007, page 2 and 3.
[119] See *Perkowski*, Col. 19, lines 41-55.

3. Conclusion – TSM Test.

Although the recent *KSR* Supreme Court case has indicated that the teaching-suggestion-motivation (TSM) test is not a rigid test, it is still considered to be a factor. Under this test, there must be some type of teaching in each of the references for combination as well as some kind of suggestion. There also must be some motivation to combine the three references. If this test alone is utilized, the question would be whether there is any teaching in *Borecki* and *Perkowski* that would suggest to one skilled in the art to combine the references or is there any motivation to so combine.

Further, Appellants submit that neither *Borecki* nor *Perkowski* discloses all the limitations of Independent Claim 1. In particular, it is submitted that the primary citation to *Borecki* does not disclose the claimed coded information extracted from an MRC, the extracted coded information associated with routing information that is associated with both the personal account information of the user and a specific and unique credit card company server having stored thereat the personal account information of the user. Accordingly, without conceding the propriety of the asserted combination, the asserted combination of *Borecki* and *Perkowski* is likewise deficient, even in view of the knowledge of one of ordinary skill in the art.

Borecki provides a private and secure account to enable a user to make private and secure purchases via the Internet. A registered user accesses the internet and chooses to connect to a central server by entering a known URL. After accessing the central server located on the internet, the registered user enters a member number, User ID and password to sign-on to the system. The user is then provided with account information in the form of a digital checkbook and temporary debit and credit card numbers for use in electronic purchases. However, there is no disclosed use of a machine resolvable code disposed on the credit card of a user wherein the MRC is associated with personal account information of the credit card associated with the user (as set forth in the preamble of the claim). Additionally, *Borecki* contains no disclosure that extracted information is *transmitted* to the central server to determine the personal account information. As such, *Borecki* only discloses an account system, whereby, after the user enters a known URL to connect to the system via the internet; then, the user enters a member number, User ID and Password to obtain access to the user's account information. *Borecki* contains no suggestion, teaching or motivation for using an MRC located on a credit card of a user to *both*

access a credit card server located on the internet *and* second locate personal account information of the user could be useful for its intended purpose. Further, *Borecki* teaches away from using a single code for accessing the secure and private server wherein *Borecki* explicitly requires the separate entry of three separate pieces of information: the member number, User ID, and password.

Perkowski provides for scanning the UPC of a product and accessing advertising information associated with a registered product. When placed in a "finder mode," the system allows a predetermined information resource to be accessed by simply entering the registered product's UPN. *Perkowski* teaches that a scanner may be used to enter the 12-digit, human readable number encoded in the registered product's UPN into the user's browser on the user's personal computer. However, the information extracted from the UPN is only the 12-digit human readable number. *Perkowski* contains no disclosure that this encoded information is associated with routing information associated with both the personal account information of the user *and* the specific and unique server having the personal account information stored thereat. Additionally, *Perkowski* contains no disclosure that the routing information is obtained *in response* to the step of extracting coded information from the MRC. As such, *Perkowski* merely provides a translation database that returns URLs registered with the 12-digit UPC number of the product. *Perkowski* contains no teaching, suggestion or motivation for a single MRC that is associated with a credit card and a user be utilized to perform the steps set forth in *Borecki*, i.e., that of connecting the user to the secure server and then determining the personal account information based upon the MRC.

Based on the TSM test, the Examiner's position is conclusory. Clearly, *Perkowski* is merely utilized for scanning the UPC in order to obtain information about a product utilizing that product code (i.e., UPC). The product code is specifically associated with that product and the product code is utilized to obtain information in *Perkowski* after accessing a particular web site. The code contains nothing that would return the location of a particular web site that would have an association with personal account information in addition to transmission of that code to the access location for the purpose of then using that code to obtain the personal account information. In order to have such an MRC, *Perkowski* would require that there be a relational database at a first location for determining the location of the credit card server and then a

relational database stored at the credit card server for determining the personal account information. However, *Perkowski* contains no such teaching or suggestion and it is this lack of teaching, suggestion or motivation to utilizing an MRC to replace two steps, the first step being the accessing of the credit card server and the second being the accessing of personal account information. These are two different steps that must inherently be conducted at two different locations. As such, *Borecki* and *Perkowski*, taken singularly or in combination, do not anticipate or render obvious Appellants' present inventive concept, as set forth in Claims 1-5 and 7-12.

Therefore, no reason, motivation or suggestion exists to combine *Borecki* with *Perkowski*. *Borecki* has no need to use the UPC of *Perkowski*, as the *Borecki* system provides a member number, User ID, and password to enable a user to sign-on to the system and obtain access to the user's personal account information. Since the coded information in the UPC in *Perkowski* only enters the 12-digit number into a browser to be used, after a user connects to the system, by a server to return links that registered to the 12-digit number, the question is "Why would one skilled in the art want to use a 12-digit number, encoded into a UPC to transmit to a central server where at least a member number or User ID and password would still be required in order to maintain the security of the *Borecki* system? The Examiner states that one skilled in the art would combine *Borecki* with *Perkowski* for the purpose of enhancing the user friendliness of the system by automating manual data entry and automatically retrieving credit card information. However, there is no motivation or suggestion that would in any way lead one skilled in the art to combine such. Combining *Borecki* with *Perkowski* still would require the user to enter a URL address, either by typing or selecting a pre-programmed button; then enter, either manually or by a scanning operation, a number to obtain a separate URL; then selecting a URL from a list of URLs provided; then, still, enter a User ID and password in order to obtain access to account information. As such, the user still would be required to perform extensive manual entry and the system user friendliness would not be enhanced but, rather, increased. Thus, *Perkowski* does not provide a disclosure that remedies the aforementioned, conceded deficiency in the primary citation to *Borecki*.

4. *KSR* Test:

The recent *KSR* case, although not fully analyzed as to its impact on obviousness type rejections under 35 U.S.C. § 103, indicates that the test is "if a person of ordinary skill can not

implement a *predictable variation*, §103 likely bars it's patentability."[120] The question would be whether *Borecki* could be varied in a predictable manner under this dicta to obtain routing information associated to both personal account information and a specific and unique credit card server, in response to extracting information from an MRC on a credit card, wherein the personal account information is stored at the specific and unique credit card server. *Borecki* would receive no benefit in using UPC information regarding a product to access a website containing product information. In Claim 1, the MRC performs two steps in response to the step of extracting the coded information: first, to obtain routing information to the specific and unique server; second, connect to the specific and unique credit card server in accordance with the obtained routing information, and in response to transmitting the extracted information, determining the personal account information of the user stored at the specific and unique credit card server. If the UPC information were used in the *Borecki* system, there is no indication that the extracted information could provide routing information associated to both the personal account information and the specific and unique credit card server, or that connects the user to the specific and unique credit card server in accordance with the associated routing information, if it existed. As such, there is no predictable variation of *Borecki* that would lead one skilled in the art to utilize the *Perkowski* UPC. When work is available in one field of endeavor, i.e., providing access to secure personal account information on a credit card server on located on the Internet, there is no design incentive or other market force that would prompt a predictable variation of the *Borecki* reference to utilize UPC content for a purpose that is not useful or envisioned in *Borecki*. Further, the Examiner has not entered such a rejection and, as such, Appellants have not been provided the opportunity to fully develop an evidentiary record to counter such argument. Until such argument has been put forth by the Examiner, Appellants will not be able to counter such with appropriate evidence, as entering such is not in this stage of the prosecution is difficult if not impossible. Therefore, such a discussion of such by either the examiner or the Board is not believed to be proper. In summary, Appellants submit that the Examiner has failed to provide a *prima facie* case as to why the *Borecki* and *Perkowski* references, in combination, render obvious Appellants' present inventive concept, as defined by Claims 1-5 and 7-12.

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[120] *KSR,* 127 S. Ct. at page 1740.

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D. Dependent Claim 2-5 and 8 as rejected by the combination of Borecki et al. and Perkowski.

Regarding Claims 2-5 and 8, the Examiner states in the Final Office Action dated October 5, 2006:

> As to claims 2-5, and 8, Borecki-Perkowski teach *(sic)* the system wherein the MRC is an optical indicia, a barcode, wherein the optical indicia is used to extract the corresponding routing information and personal identification information, wherein a unique code is transmitted to a remote intermediate location, and returning a matched remote location information to the user (Borecki, Figure 2A and page 2, paragraph 0034-0035 and Perkowski, col. 3, line 63 - col. 4, line 4; col. 5, lines 19-26; and col. 19, lines 12-55).[121]

The Examiner contends that the combination of *Borecki* and *Perkowski* renders obvious dependent Claims 2-5 and 8. Claims 2-5 and 8 depend from, and further limit, Independent Claim 1. These dependent claims are allowable for at least the same reasons as the claim from which they depend, as discussed above. Additionally, Appellants submit that the combination of *Borecki* and *Perkowski* does not anticipate or render obvious Claims 2-5 and 8, even in view of the knowledge of one of ordinary skill in the art.

Dependent Claim 2 recites a method of Claim 1 wherein the MRC is optical indicia. Dependent Claim 3 recites a method of Claim 2 wherein the optical indicia is a bar code. *Perkowski* does teach the use of a UPC with a human-readable 12-digit number below the bar-code.

Dependent Claim 4 recites a method of Claim 1 wherein the routing information, in the step of obtaining, is stored on a user computer at the user location such that the coded information, in the step of extracting, is used to obtain the corresponding routing information from the user computer. The Examiner again cites *Borecki* at page 2, paragraphs 0034-0035 and *Perkkowski*, col 3, line 63 – col. 4, line 4; col. 5, lines 19-26; and col. 19, lines 12-55. The relevant sections from *Borecki* and *Perkowski* are:

In *Borecki*:

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[121] See Final Office Action dated October 5, 2006, at pages 4 and 5.

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FIG. 2A is a flowchart 70 which diagrams procedures executed by and implemented in central computer system 12 of system 10 (shown in FIG. 1). After *a user initiates 72 Internet access*, they choose to connect 74 to the private and secure purchases provider web site. The user may choose to exit 76 at this time. Alternatively, if the user chooses to continue, they are queried 78 if they are accessing central computer system 12 for the first time. If the user is accessing for the first time, a sign up process is initiated 80 which is described in further detail in FIG. 2B below. If not accessing for the first time, the user establishes 82 a secure connection to the private and secure purchases provider web site, and enters 84 their digital checkbook, which is described in further detail in FIG. 2C below.

The user then chooses whether to request and obtain 86 account information or to display 88 their checkbook with account information. After account information is requested and obtained 86, the checkbook with account information is displayed 88. After display 88 of checkbook with account information, the user opens the checkbook and is issued 90 secure temporary card numbers, both debit and credit, for Internet purchases, which are described in further detail in FIG. 2E below. After temporary card numbers are issued 90, the user chooses 92 whether or not to make purchases via the Internet. The user exits 94 if no purchasing is to be done at this time. Internet purchasing is further described in FIG. 2F below.[122] *(emphasis added)*

In *Perkowski*:

> Another object of the present invention is to provide such a system, wherein when the system is in its IPSI Finder Mode, a predesignated information resource (e.g. advertisement, product information, etc.) pertaining to any commercial product or service registered with the system can be automatically accessed from the Internet and displayed from the Internet browser by simply entering the registered product's UPN or the registered service's USN into the Internet browser.[123]

> Another object of the present invention is to provide such a system and method in the form of an electronic kiosk installed within a store and having an automatic projection-type, laser scanning bar code symbol reader for reading the UPC numbers on products being offered for sale in the store, and also a video

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[122] See *Borecki*, page 2, paragraphs 0034-0035.
[123] See *Perkowski*, col. 3, lines 63-67; and Col. 4, lines 1-4.

display screen for displaying product-related information accessed from hyper-linked Web-sites on the Internet.[124]

When the system is in this operational mode, as illustrated in FIGS. 3A, 4A and 5A, 6A, a Web-based information resource pertaining to any commercial product or service registered with the system can be displayed and selected by the user in order to automatically access the same from the Internet. Such information resources can include advertisements, specifications, operation descriptions, product simulations, purchase information, maintenance information, warranty and servicing information, product updates, distributor information, incentives (e.g. discounts, rebates, coupons, etc.), electronic data transaction screens, etc. In this mode, desired product or service information is obtained by simply manually entering the registered product's UPN (e.g. its UPC's 12 digit numerical string) or the registered service's USN (e.g. its UPC's 12 digit numerical string) into the dialogue box of the Internet browser or Internet application tool. When using the seeded IPSI Database described hereinabove, only the first six digits of the UPC number need be entered into the dialogue box. An exemplary display screen produced from the IPSD Server might be as follows:

> "Simply enter the 12 digit UPC the particular product; click REQUEST, and then wait for the display of the list of Web locators (URLs) at which the desired product information can be found on the Internet."

Alternatively, a bar code symbol scanner can be used to enter the UPSN (e.g. UPC or USC number) into the system, thereby avoiding manual keyboard entry operations.

In response to such data entry operations, *a list of URLs organized according to the information subfield classifications set forth in FIG. 2A2 are displayed on Client System C_a making the request of the IPSD Server*. At this stage, another display screen would appear with an exemplary message as follows:

> "Please select the URL from the displayed URL list using the information subfield product information category displayed above. This will connect you to the product information related to the selected URL. You can return to the URL display list at anytime."

Upon selecting a particular URL from the displayed URL list, video and audio information content are automatically displayed on the Client System from the IPSI Server hosting the selected URL.[125] *(emphasis added)*

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[124] See *Perkowski*, col. 5, lines 19-26.
[125] See *Perkowski*, Col. 19, lines 12-55.

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Borecki teaches that a user must access a website by entering the website URL, for example http://InterChecks.com, as referenced by *Borecki* Figure 2A. Clearly, *Borecki* does not disclose storing any routing information *on* the user computer at the user location. *Perkowski* discloses that URLs registered with the corresponding UPC are displayed on a display of the user computer. However, *Perkowski* does not teach or suggest that the URL's are stored at the user computer such that, when the UPC is scanned the 12-digit number is extracted therefrom, the URL registered with the scanned UPC is retrieved from a translation database (e.g., the IPSI Registrant Database[126]) and stored on the user computer. *Borecki* and *Perkowski*, taken singularly or in combination, do not disclose the aforementioned feature of Dependent Claim 4. Accordingly, without conceding the propriety of the asserted combination, the asserted combination of *Borecki* and *Perkowski* is likewise deficient, even in view of the knowledge of one of ordinary skill in the art.

Additionally, Dependent Claim 5 recites a method of Claim 4 wherein the user stores a plurality of coded information, each associated with unique routing, such that the reading of one of one or more credit cards of the user cause the user computer to connect to the corresponding specific and unique credit card company server over the network. *Borecki* and *Perkowski*, taken singularly or in combination, do not disclose the storing a plurality of coded information. As such, *Borecki* and *Perkowski*, taken singularly or in combination, do not disclose the aforementioned feature of Claim 5.

E. Dependent Claim 7 as rejected by the combination of Borecki et al. and Perkowski.

Regarding Claim 7, the Examiner states in the Final Office Action dated October 5, 2006:

> As to claim 7, Borecki-Perkowski teach *(sic)* the use of a computer display at the user location (Borecki, page 2, paragraph 0034-0035 and page 3, paragraph 0040).[127]

Claim 7 depends from, and further limits, Independent Claim 1. This dependent claim is allowable for at least the same reasons as the claim from which it depends, as discussed above.

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[126] See *Perkowski*, Col. 15, lines 60-63 (also referenced hereinabove with respect to Independent Claim 1).
[127] See Final Office Action dated October 5, 2006, at page 5.

F. Dependent Claims 9 and 11 as rejected by the combination of Borecki et al. and Perkowski.

Regarding Claims 9 and 11, the Examiner states in the Final Office Action dated October 5, 2006:

> As to claims 9 and 11, Borecki-Perkowski teach *(sic)* a method for accessing personal information from a remote location on a network, as applied to claim 1 above, comprising the steps of:
>
> reading at a user location on the network a unique information access code disposed on a portable access device that is carried by a user, which unique information access code is associated with routing information on the network to the remote location and also with personal information at the remote location of a user that is associated with the portable access device (Perkowski, col. 3, line 63 - col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55);
>
> accessing the remote location in accordance with the routing information (Perkowski, col. 19, lines 12-55);
>
> transmitting to the remote location the unique information access code (Borecki, Figure 2A and page 2, paragraph 0034-0035 and page 3, paragraph 0039); and
>
> at the remote location, receiving the unique information access code and accessing personal information associated therewith and forwarding the personal information back to the user location for viewing by the user (Borecki, Figure 2A and page 2, paragraph 0034-0035 and page 3, paragraph 0039); the step of forwarding comprising:
>
> sending from the remote location a request for personal identification after determining that there is contained in the database local to the remote location personal information associated with the unique information access code (Borecki, paragraphs 0034-0035),
>
> entering the personal identification information at the user location (Borecki, paragraphs 0034-0035 and 0039-0040); and
>
> in response to input of a personal identification information by the user, returning the personal information to the user location (Borecki, paragraphs 0039-0040).[128]

Independent Claim 9 recites a method for accessing personal information from a remote location on a network. The first step of Independent Claim 9 is to read, at a user location on the network, a unique information access code disposed on a portable access device that is carried by a user, which unique information access code is uniquely associated with both routing

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[128] See Final Office Action dated October 5, 2006, at pages 5 and 6.

information on the network to the remote location and with personal information at the remote location of a user that is associated with the portable access device, wherein the association of the remote location with the unique information access code is unique to such unique information access code such that only that single remote location contains the associated personal information. The Examiner cites *Perkowski* at col. 3, line 64 – col. 4, line 4, col. 5, lines 19-26 and col. 19, lines 12-55 to provide this teaching. As stated hereinabove with respect to Independent Claim 1, *Perkowski* merely discloses a UPC on a product that is used in a translation database to retrieve URLs registered with that UPC. *Perkowski* contains no disclosure that the product is a *portable access device* or that the UPC is uniquely associated with both routing information on the network to a remote location and with personal information, of the user at the remote location. Further, *Perkowski* contains no disclosure that the product would be associated with the user. As such, the UPC is not a unique information access code disposed on a portable access device carried by a user. Thus, *Perkowski* cannot reasonably be interpreted to disclose the aforementioned feature of Independent Claim 9.

Further, Independent Claim 9 recites obtaining the routing information from a database by comparing the unique information access code in a matching operation to a record in the database to determine if there exists in the record a pre-association between the unique information access code and at least one routing information and, if so, then allowing access to such matching routing information; and accessing the remote location in accordance with the obtained routing information. The Examiner cites *Perkowski*, col. 19, lines 12-55 for this teaching. *Perkowski* does disclose that the UPC, though not conceded as a unique information access code, is used to return URLs registered with the UPC and that the URLs can be selected for access to a remote location.

Next, Independent Claim 9 recites transmitting to the remote location, the unique access code. The Examiner provides *Borecki*, Figure 2A and page 2, paragraphs 0034-0035, and page 3, paragraph 0039 for this teaching. As stated hereinabove, *Borecki* expressly teaches away from the use of a single code as *Borecki* requires 3 separate entries (a member number, User ID and password) to ensure security and privacy. *Borecki* does not disclose the transmission of a unique access code to the remote server. Thus, *Borecki* cannot reasonably be interpreted to disclose the aforementioned feature of Independent Claim 9.

Further, Independent Claim 9 recites, at the remote location, receiving the unique information access code and accessing personal information associated therewith and forwarding the personal information back to the user location for viewing by the user. Thereafter, Independent Claim 9 recites that the user enters the personal identification information at the user location. Finally, in response to input of the personal identification information by the user, the remote location returns the personal information to the user location.

The Examiner contends that the UPC information in *Perkowski* can be combined with the *Borecki* account information. Neither *Borecki* nor *Perkowski*, taken singularly or in combination, teaches a unique access code on a portable access device that, in response to reading the unique access code, a connection is made to a remote location and the unique access code is transmitted to the remote location. Accordingly, without conceding the propriety of the asserted combination, the asserted combination of *Borecki* and *Perkowski* is likewise deficient in teaching accessing an intermediate location in response to scanning the UPC and transmitting the extracted information to the intermediate location accessed as a result of the scanning operation, even in view of the knowledge of one of ordinary skill in the art.

G. Dependent Claim 10 as rejected by the combination of Borecki et al. and Perkowski.

Regarding Claim 10, the Examiner states in the Final Office Action dated October 5, 2006:

> As to claim 10, Borecki-Perkowski teach the method wherein the network is a global communication network (Borecki, page 2, paragraph 003 1).[129]

Claim 10 depends from, and further limits, Independent Claim 9. This dependent claim is allowable for at least the same reasons as the claim from which it depend, as discussed above.

H. Dependent Claim 12 as rejected by the combination of Borecki et al. and Perkowski.

Regarding Claim 12, the Examiner states in the Final Office Action dated October 5, 2006:

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[129] See Final Office Action dated October 5, 2006, at page 6.

As to claim 12, Borecki-Perkowski teach the method wherein the step of accessing comprises the steps of:

in response to the step of reading, accessing an intermediate location on the network remote from the user location (Perkowski, col. 3, line 63 - col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55);

transmitting the unique information access code to the intermediate location from the user location (Perkowski, col. 3, line 63 - col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55);

the intermediate having contained thereat a database with associations between a plurality of unique information access codes and remote locations on the network (Perkowski, col. 3, line 63 - col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55);

comparing the received unique personal access code with the stored personal access code (Perkowski, col. 3, line 63 - col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55);

if a match is found, returning the matched remote location information to the user location (Perkowski, col. 3, line 63 - col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55); and

utilizing the returned remote location information from the intermediate location to access the remote location (Perkowski, col. 3, line 63 - col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55).[130]

Claim 12 depends from, and further limits, Independent Claim 9. This dependent claim is allowable for at least the same reasons as the claim from which it depends, as discussed above. Dependent Claim 12 recites a method of Claim 9, wherein the step of obtaining and accessing comprises the steps: of *in response to the step of reading*, accessing an intermediate location on the network remote from the user location; *transmitting the unique information access code* to the intermediate location from the user location; the intermediate location having contained thereat the database with associations between a plurality of unique information access codes and associated unique routing information to associated remote locations on the network; comparing the received unique information access code with the stored unique information access codes; if a match is found, returning the matched unique routing information to the user location; and utilizing the returned unique routing information from the intermediate location to access the remote location. Claim 12 includes the limitations of accessing an intermediate location on the web in response to the step of extracting and transmitting the unique information access code to the intermediate location, as found in Independent Claim 1. Accordingly, without conceding the

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[130] See Final Office Action dated October 5, 2006, at pages 6 and 7.

propriety of the asserted combination, the asserted combination of *Borecki* and *Perkowski* is likewise deficient in teaching accessing an intermediate location in response to scanning the UPC and transmitting the extracted information to the intermediate location accessed as a result of the scanning operation, even in view of the knowledge of one of ordinary skill in the art.

I. Conclusion - Claims 2-5, and 7-12 as rejected by the combination of Borecki et al. and Perkowski.

The Examiner maintains the 35 U.S.C. § 103(a) rejection of Claims 2-5 and 7-12 as rejected by the combination of *Borecki* and *Perkowski*. As stated hereinabove, Claims 2-5 and 7-8 depend from, and further limit Independent Claim 1. These claims are allowable for at least the reasons as the claim from which they depend. Additionally, the combination of *Borecki* and *Perkowski* fails to teach all the limitations found in Claims 2-5 and 7-8 as outlined above.

In respect to Claims 9-12, Independent Claim 9 contains limitations as found in Independent Claim 1. Therefore, Independent Claim 9 equally is allowable for the reasons outlined with respect to Independent Claim 1. Also, as stated hereinabove, Claims 10-12 depend from, and further limit, Independent Claim 9. These claims are allowable for at least the reasons as the claim from which they depend.

Further, the Examiner has provided no articulated reasoning why one skilled in the art would make such a combination. Somehow the Examiner is bridging the gap from a 12-digit code provided on a product for purchase that can be registered with a URL in a translation database and a member number, User ID and password used to access a personal account, to a system wherein a unique access code on a portable access device is used to provide routing information associated with the remote location on the network and the location of the personal account information stored at the remote location information. The combination provided by the Examiner would somehow use the 12-digit UPC number as member number disposed on a credit card (as found in Claim 11 of the instant application), uniquely associated with personal account information of the purchaser of the product, that, when scanned, provides a connection from the purchaser's computer to a remote location on the network; then, transmitting the scanned information to the remote location which, in response, prompts the purchaser to enter personal

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identification information in order to receive the personal account information regarding the purchaser that is stored at the remote location. However, the Examiner has provided no articulated reasoning how this gap is bridged. As such, the combination of *Borecki* and *Perkowski* does not anticipate or render obvious Appellants' present inventive concept, as set forth in Claims 9 and 11.

J. Dependent Claim 6 as rejected by the combination of Borecki-Perkowski and Brook et al.

Regarding Claim 6, the Examiner states in the Final Office Action dated October 5, 2006:

> As to claim 6, Borecki-Perkowski teach *(sic)* the invention substantially as claimed. However, Borecki-Perkowski does not explicitly teach a wireless scanner. In the same field of endeavor, Brook teaches a wireless barcode scanner (Brook, figure 1 and col. 3, line 6 - col. 4, line 41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the wireless barcode scanner, as taught by Brook, into the system of Borecki-Perkowski, for the purpose of increasing user convenience and mobility.[131]

The Examiner provides *Brook* to cure the deficiencies of *Borecki-Perkowski*. *Brook* teaches a drug tracking system and method for use in hospitals, pharmacies, etc.[132] *Brook* provides a portable access scanner/printer that can communicate via an RF link to a Personal Computer based server.[133]

Claim 6 recites a method of Claim 1, wherein the step of resolving utilizes a reading device which is a wireless scanner which transmits the coded information to a user computer at the user location via a receiving device operatively connected to the user computer. The secondary citation to *Brooks* relates to a drug tracking system for hospitals and pharmicies and is cited for its alleged disclosure of a wireless bar code scanner. Appellants submit that *Brooks* does not add anything that would remedy the aforementioned deficiency in *Borecki-Perkowski*. Claim 6 depends from, and further limits Independent Claim 1. This claim is allowable for at least the reasons as the claim from which it depends, as discussed above. Accordingly, favorable

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[131] See Final Office Action dated October 5, 2006, at pages 7 and 8.
[132] See *Brook*, Abstract.
[133] See *Brook*, Col. 5, lines 17-67; and Col. 6, lines 1-43.

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reconsideration and withdrawal of the rejection of Claim 6 under 35 U.S.C. §103 are respectfully requested.

K. Independent Claim 1 as rejected by the combination of Perkowski and Janning et al.

The Examiner additionally rejects Claims 1 and 9 as being unpatentable over the combination of *Perkowski* and *Janning*. The Examiner states in the Final Office Action dated October 5, 2006:

> As to claims 1 and 9, Perkowski teaches the invention substantially as claimed. Perkowski teaches a system and method of accessing information associated with a user over a global communication packet-switched network, comprising the steps of:
>
> at a user location disposed on the network, resolving a machine-resolvable code (MRC) having coded information contained therein and disposed on an object, the coded information having no personal information contained therein relating to the user (Perkowski, col. 3, line 63 - col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 38-40);
>
> extracting coded information from the MRC, the coded information associated with routing information that is associated with both the personal information of the user and a company server (Perkowski, col. 19, lines 12-55);
>
> in response to the steps of resolving and extracting, obtaining the routing information to the server associated with the extracted coded information (Perkowski, col. 19, lines 12-55);
>
> connecting the user location to the company server across the network over a determined route in accordance with the routing information such as a known URL (Perkowski, col. 19, lines 12-55);
>
> transmitting the information to the specific and unique company server over the network (Perkowski, col. 19, lines 12-55);
>
> using the information at the specific and unique company server to determine the information associated with the customer information from the company server, to the user location (Perkowski, col. 3, line 63 - col. 4, line 4; and col. 19, lines 38-40); and
>
> presenting the information to the user at the user location (Perkowski, col. 3, line 63 - col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 38-40). [134]

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[134] See Final Office Action dated October 5, 2006, at pages 8 and 9.

The Examiner states that *Perkowski* teaches the invention *substantially as claimed*, providing *Janning* to teach only that the information is credit card information. As such, the Examiner contends that *Perkowski* teaches a method of accessing personal account information of a credit card associated with a user over a global communication packet-switched network, comprising the steps of: at a user location disposed on the network, resolving a machine-resolvable code (MRC) having coded information contained therein, the coded information having no personal information contained therein relating to the user or routing information over a network; extracting the coded information from the MRC, the coded information associated with routing information that is associated with both the personal account information of the user and a specific and unique server having stored threat the personal account information of the user; in response to the steps of resolving and extracting, obtaining the routing information to the server associated with the extracted coded information; connecting the user location to the specific and unique server across the network over a determined route in accordance with the obtained routing information; transmitting the extracted coded information to the specific and unique server over the determined route during the step of connecting; using the transmitted coded information at the specific and unique server to determine the personal account information associated with the extracted coded information; returning the determined personal account information from the specific and unique server to the user location; and presenting the determined personal account information to the user at the user location. However, this is inconsistent with the Examiner's 35 U.S.C. § 103(a) rejection of Claims 1 and 9 as being unpatentable over the combination of *Borecki* and *Perkowski* wherein the Examiner provided *Borecki* to teach:

> … a system and method of accessing personal account
> information of a credit card associated with a user over a global
> communication packet-switched network, comprising the steps of:
> connecting a user location to the specific and unique credit card
> company server across the network in accordance with a known
> URL (Borecki, Figure 2A and page 2, paragraph 0034-0035);
> transmitting the account information to the specific and unique
> credit card company server over the network (Borecki, Figure 2A
> and page 2, paragraph 0034-0035 and page 3, paragraph 0039);
> using customer account information at the specific and unique
> credit card company server to determine the personal account
> information associated with the customer account information

from the credit card company server, to the user location (Borecki, page 3, paragraph 0040); and

presenting the information to the user at the user location (Borecki, page 2, paragraph 0034-0035 and page 3, paragraph 0040).[135]

Applicant submits that neither *Perkowski* nor *Janning* discloses at least the aforementioned feature of Independent Claim 1. As stated hereinabove, *Perkowski* provides a method and system for finding and serving consumer product-related information on the Internet.[136] *Perkowski* is directed towards the concept of providing an interface to a user to allow that user to search information regarding either a product having an associated Universal Product Code (UPC) or Universal Product Number (UPN) or information regarding products associated with the trademark (noting this association is not disclosed as being on a product or brochure), there are provided two methods of operation.[137] Each of these systems utilizes a browser programmed as the GUI-based interface for the user. The two independent modes of operation are the "Internet Product Service Information (IPSI) Find Mode" (and the "UPSN Search Mode" system.[138] The user may be provided with an icon on their local internet browser.[139] Alternatively, the user selects an icon within an internet browser on their computer.[140] Upon selection of the icon, the user is connected through the internet to the IPSI Web-site.[141] The web-site may be accessed by a known URL, such as http://www.ipsi.com.[142] Regardless of whether the user is required to access the IPSI web-site first or is provided an icon on their browser, the user must select the IPSI finder button to initiate the functionality of the *Perkowski* system.[143] Selecting the IPSI finder button transmits entered UPC information to the IPSI server located on the internet.[144] When selecting the IPSI finder button, the user enters the product UPC information.[145] The UPC is encoded with a 12 digit number representing a manufacturer (first 6 digits), product (next 5 digits), and a check digit. The 12 digit, human readable number is

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[135] See Final Office Action, mailed February 14, 2007, pages 2-3.
[136] See *Perkowski*, Abstract.
[137] See *Perkowski*, Col 3, lines 55-67; and Col. 4, lines 1-14.
[138] See Perkowski, starting at Col 18, line 55 in the section entitled "Operation of the IPSI Finding System and Method."
[139] See *Perkowski*, Col 8, lines 25-36.
[140] See *Perkowski*, Col 8, lines 37-45.
[141] See *Perkowski*, Col 8, lines 45-55.
[142] See *Perkowski*, Col 8, lines 55-60.
[143] See *Perkowski*, Col 8, lines 64-67; Col. 15, lines 53-60.
[144] See *Perkowski*, Col 8, lines 39-55; Col. 15, lines 55-59.
[145] See *Perkowski*, Col 15, lines 55-59.

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printed on the bottom of the UPC.[146] A user may manually enter a registered product's UPN (e.g., the UPC 12 digit numerical string) into a dialogue box of an Internet browser or Internet application tool.[147] The user may also scan the UPSN (Universal Product / Service Number – i.e., UPC) with a bar code symbol scanner.[148] Regardless of the method of entry of the UPC, the system (i.e., the IPSI server) performs a query based upon the UPC to determine if a corresponding URL for the product/manufacturer exists in an IPSI Registrant Database.[149] If so, the URL, or list of URL's is provided to the user.[150] Thereafter, the user selects a URL corresponding to a web-site the user desires to access.[151]

As discussed hereinabove, *Perkowski* does not teach an MRC having encoded information associated with routing information associated with *both* personal account information and a specific unique server where the personal account information is stored. Additionally, *Perkowski* does not teach obtaining routing information *in response* to extracting coded information from the MRC. Further, *Perkowski* teaches that the user computer connects to the IPSI Server in response to the user selecting the IPSI Finder button, wherein the 12-digit UPC code (whether entered or scanned) is transmitted to the IPSI server. Thereafter, the IPSI server returns a URL, or URLs, registered with the 12-digit UPC number. *Perkowski* contains no teaching, suggestion, or motivation for extracting coded information from an MRC to obtain routing information to a server that contains personal account information of the user; then transmitting, to the server, the extracted information to determine and return the personal account information of the user. *Perkowski* teaches, and is limited to teaching, entering a 12-digit UPC number into a browser system at a user computer; selecting an IPSI Find mode to connect to an IPSI server; accessing a database at the IPSI server; obtaining URLs registered with the 12-digit UPC; returning the URLs to the user computer; whereby the user can select a URL to connect to for viewing product information. Thus, *Perkowski* cannot reasonably be interpreted to disclose the aforementioned features of Independent Claim 1.

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[146] See *Perkowski*, Col 12, lines 3-19.
[147] See *Perkowski*, Col 19, lines 23-28.
[148] See *Perkowski*, Col 19, lines 38-40.
[149] See *Perkowski*, Col 15, lines 60-67.
[150] See *Perkowski*, Col 15, lines 60-67; and Col. 19, lines 41-44.
[151] See *Perkowski*, Col 19, lines 45-55.

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Additionally, *Perkowski* does not disclose that the information is disposed on a credit card and that the information retrieved is credit card related information. The Examiner concedes that the primary citation to *Perkowski* does not disclose credit card related information or a specific and unique credit card server. The Examiner states:

> However, Perkowski does not explicitly teach the information is credit card information and personal information is credit card related information. In the same field of endeavor, Janning teaches a system and method for accessing user credit card related information, such information having no personal information contained therein relating to the user, and using this information to access user's personal credit card account online (See Janning, Abstract and col. 28, line 1 - col. 29, line 4).
>
> It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the credit card access system of Janning into the automated information access system of Perkowski for the purpose of easily and efficiently obtaining user's credit information while maintaining anonymity as well as convenience.[152]

Thus, the Examiner is utilizing *Janning* to teach a system and method for accessing user credit card related information wherein the information has no personal information contained therein relating to the user and then this information is used to access the user's personal credit card account online. Accordingly, without conceding the propriety of the asserted combination, the asserted combination of *Perkowski* and *Janning* is likewise deficient, even in view of the knowledge of one of ordinary skill in the art.

The secondary citation to *Janning* relates to a cashless business transaction system.[153] A transaction controller will determine whether billing information is included in the radio signal.[154] The controller determines whether billing information is included in the radio signal by comparing digital information provided by the receiver to stored account numbers in a centralized computer database.[155] In a preferred example, there is described the situation where a string of bits received from the receiver are determined whether to correspond to a credit card

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[152] See Final Office Action dated October 5, 2006, at pages 8 and 9.
[153] See *Janning*, Abstract.
[154] See *Janning*, Col. 28, lines 27-29.
[155] See *Janning*, Col. 28, lines 30-33.

account number, a debit account number or some other bank account number and whether these bits contain account validity information, such as a credit card expiration date, etc.[156]

In order to accomplish the functions described in *Janning*, some type of relational database must be used or associated therewith. As such, all that *Janning* teaches, and is limited to teaching, is that some kind of code can be obtained and credit card information can be looked up. This is no different than *Borecki*, wherein the user inputs a User ID and password and the User ID and password is utilized to obtain an association with some type of account information either directly or indirectly. Thus, *Janning* does not provide a disclosure that remedies the aforementioned, conceded deficiency in the primary citation to *Perkowski*.

L. Conclusion – Independent Claims 1 and 9 as rejected by the combination of Perkowski and Janning et al.

The combination of *Perkowski* and *Janning* does not disclose or suggest that an MRC would be coded such that the coded version thereof can first be utilized to determine a location to a destination website and, after the destination website is decoded, to then transfer the information to the destination website to access account information. The claims of the instant application require the extracted code associated with a destination website address for a secure server and also associated with user account information at the destination web server. In *Perkowski*, the bar code is a UPC number registered with a website and there is no reason to extract the encoded information in order to then determine the location to the destination website and, thereafter, transfer this decoded information to the destination website and access information associated therewith. Thus, an association must exist between both the destination website and the user account information, which association is not suggested or disclosed in either *Perkowski* or *Janning* or in the combination thereof. Since the information in *Janning* only relates to credit card information and the information in the UPC in *Perkowski* only enters the 12-digit number into a browser to be used, after a user connects to the system, by a server to return links that registered to the 12-digit number, the question is "Why would one skilled in the art want to use a 12-digit number, encoded into a UPC of a product to retrieve the credit card information as in the *Janning* system? The Examiner states that one skilled in the art would combine *Perkowski* with *Janning* for the purpose of easily and efficiently obtaining user's credit

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[156] See *Janning*, Col. 28, lines 34-52.

information while maintaining anonymity as well as convenience. However, there is no motivation or suggestion that would in any way lead one skilled in the art to combine such. Combining *Perkowski* with *Janning* still would require the user to somehow identify their personal account information at the credit card server. Thus, *Janning* does not provide a disclosure that remedies the aforementioned, conceded deficiency in the primary citation to *Perkowski*. As such, *Perkowski* and *Janning*, taken singularly or in combination, do not anticipate or render obvious Appellants' present inventive concept, as set forth in Claim 1.

1. *KSR* Test:

Under the *KSR* Test, the question would be whether *Perkowski* could be varied in a predictable manner under this dicta to obtain routing information associated to both personal account information and a specific and unique credit card server, in response to extracting information from an MRC on a credit card, wherein the personal account information is stored at the specific and unique credit card server. *Perkowski* associates a particular website, or group of websites, to a particular product for purchase. In Claim 1, the MRC performs two steps in response to the step of extracting the coded information: first, to obtain routing information to the specific and unique server; second, connect to the specific and unique credit card server in accordance with the obtained routing information, and in response to transmitting the extracted information, determining the personal account information of the user stored at the specific and unique credit card server. If the UPC information were used with the *Janning* system, there is no indication that the MRC would be disposed on a credit card or that the extracted information could provide routing information associated to both the personal account information and the specific and unique credit card server, or connect the user to the specific and unique credit card server in accordance with the associated routing information, if it existed. As such, there is no predictable variation of *Perkowski* that would lead one skilled in the art to utilize the *Janning* credit card signals. When work is available in one field of endeavor, i.e., providing access to secure personal account information on a credit card server on located on the Internet, there is no design incentive or other market force that would prompt a predictable variation of the *Perkowski* reference to utilize credit card content for a purpose that is not useful or envisioned in *Perkowski*. In summary, Appellants submit that the Examiner has failed to provide a *prima facie* case as to why the *Perkowski* and *Janning* references, in combination, render obvious

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Appellants' present inventive concept, as defined by Claims 1 and 9. However, such assertion of a predictable variation has not been asserted by the Examiner during the prosecution. As such, Appellants have not been afforded the opportunity to introduce information into the record for the purpose of illustrating that work available in the field of endeavor associated with *Perkowski* would cause one skilled in the art to combine the teachings of a teaching in the field of endeavor of either of *Janning* or any other reference in a predictable manner. Such evidence could have been provided by Applicant if such rejection had been made during the prosecution phase, which did not happen.

M. Independent Claim 9 as rejected by the combination of Perkowski and Janning et al.

As stated hereinabove, Independent Claim 9 recites limitations as found in Independent Claim 1. As such, Independent Claim 9 is allowable for at least the same reasons as Independent Claim 1, as discussed above.

VIII. Conclusion

In Summary, Appellants submit that the references cited by the Examiner fail to provide a suggestion, motivation, or teaching for the various combinations because the text fails to illustrate "why" one skilled in the art would combine the references in the particular manner required to provide a predictable variation. Instead, the Examiner simply identifies particular components for each reference, combines them in a specific manner required by Appellants' claimed invention, and then states that it would be obvious to one skilled in the art to do so. This is clearly hindsight based reasoning that contravenes the standards imposed by both the MPEP and the Federal Circuit, and Appellants respectfully submit that the cited combinations are improper for reasons detailed above and requests that the rejections under § 103 be withdrawn.

Respectfully submitted,

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CLAIMS APPENDIX

Claim 1   A method of accessing personal account information of a credit card associated with a user over a global communication packet-switched network, comprising the steps of:

at a user location disposed on the network, –resolving a machine-resolvable code (MRC) having coded information contained therein and disposed on the credit card of the user, the coded information having no personal information contained therein relating to the user or routing information over a network;

extracting the coded information from the MRC, the coded information associated with routing information that is associated with both the personal account information of the user and a specific and unique credit card company server having stored thereat the personal account information of the user;

in response to the steps of resolving and extracting, obtaining the routing information to the credit card server associated with the extracted coded information;

connecting the user location to the specific and unique credit card company server across the network over a determined route in accordance with the obtained routing information;

transmitting the extracted coded information to the specific and unique credit card company server over the determined route during the step of connecting;

using the transmitted coded information at the specific and unique credit card company server to determine the personal account information associated with the extracted coded information;

returning the determined personal account information from the specific and unique credit card company server to the user location; and

presenting the determined personal account information to the user at the user location.

Claim 2   The method of Claim 1, wherein the MRC is optical indicia.

Claim 3   The method of Claim 2, wherein the optical indicia is a bar code.

Claim 4   The method of Claim 1, wherein the routing information in the step of obtaining is stored on a user computer at the user location such that the coded information in the step of extracting is used to obtain the corresponding routing information from the user computer.

Claim 5   The method of Claim 4, wherein the user computer stores a plurality of coded information each associated with unique routing information such that reading of the MRC of a

select one of one or more credit cards of the user causes the user computer to connect to the corresponding specific and unique credit card company server over the network.

Claim 6   The method of Claim 1, wherein the step of resolving utilizes a reading device which is a wireless scanner which transmits the coded information to a user computer at the user location via a receiving device operatively connected to the user computer.

Claim 7   The method of Claim 1, wherein personal account information in the step of presenting is displayed on a computer display operatively connected to a user computer at the user location.

Claim 8   The method of Claim 1, wherein the routing information in the step of obtaining comprises a network address of the specific and unique credit card company server on the network and file path information which locates the personal account information of the user on the specific and unique credit card company server.

Claim 9   A method for accessing personal information from a remote location on a network, comprising the steps of:

reading at a user location on the network a unique information access code disposed on a portable access device that is carried by a user, which unique information access code is uniquely associated with both routing information on the network to the remote location and with personal information at the remote location of a user that is associated with the portable access device, wherein the association of the remote location with the unique information access code is unique to such unique information access code such that only that single remote location contains the associated personal information;

obtaining the routing information from a database by comparing the unique information access code in a matching operation to a record in the database to determine if there exists in the record a pre-association between the unique information access code and at least one routing information and, if so, then allowing access to such matching routing information;

accessing the remote location in accordance with the obtained routing information;

transmitting to the remote location the unique information access code; and

at the remote location, receiving the unique information access code and accessing personal information associated therewith and forwarding the personal information back to the user location for viewing by the user, the step of forwarded comprising:

sending from the remote location a request for personal identification after determining that there is contained in the database local to the remote location personal information associated with the unique information access code,

entering the personal identification information at the user location, and

in response to input of a personal identification information by the user, returning the personal information to the user location.

Claim 10   The method of Claim 9, wherein the network is a global communication network.

Claim 11   The method of Claim 9, wherein the portable access device comprises a card that is typically utilized for credit transactions.

Claim 12   The method of Claim 9, wherein the step of obtaining and accessing comprises the steps of:

in response to the step of reading, accessing an intermediate location on the network remote from the user location;

transmitting the unique information access code to the intermediate location from the user location;

the intermediate having contained thereat the database with associations between a plurality of unique information access codes and associated unique routing information to associated remote locations on the network;

comparing the received unique information access code with the stored unique information access codes;

if a match is found, returning the matched unique routing information to the user location; and

utilizing the returned unique routing information from the intermediate location to access the remote location.

Claims13 - 24 (Canceled)

EVIDENCE APPENDIX

A.	U.S. Patent Publication No. 2002/0016749 A1 to Borecki et al.
B.	U.S. Patent No. 6,064,979 to Perkowski
C.	U.S. Patent No. 6,170,746 B1 to Brook et al.
D.	U.S. Patent No. 6,446,049 B1 to Janning et al.
E.	Entered Amendment dated November 20, 2006
F.	Decision from Board of Patent Appeals and Interferences regarding 2007-1745
G.	*Alza Corporation v. Mylan Laboratories, Inc.,* 464 F.3d 1286 (Fed. Cir. 2006)
H.	*Anderson's-Black Rock, Inc. v. Pavement Salvage Co.,* 396 U.S. 57 (1969)
I.	*Cable Elec. Prods., Inc. v. Genmark, Inc.,* 770 F.2d 1031 (Fed. Cir. 1985)
J.	*Cross Medical Products, Inc. v. Metronics Sofamore Danek, Inc.,* 424 F.3d 1293, 1323 (Fed. Cir. 2005)
K.	*Dann v. Johnston,* 425 U.S. at 219, 226, 96 S.Ct. 1393, 47 L.Ed 2d 692 (1976)
L.	*In re Bond,* 910 F.2d, 831, (Fed. Cir. 1990)
M.	*In re Clinton,* 527 F.2d 1226 (C.C.P.A. 1976)
N.	*In re Dembiczak,* 175 F.3d 994, 998 (Fed. Cir. 1999)
O.	*In re Hiraro,* 535 F.2d, 67, (C.C.P.A. 1966)
P.	*In re Kahn,* 441 F.3d 977, 985 (Fed. Cir. 2006)
Q.	*In re Regel,* 526 F.2d, 1399 (C.C.P.A. 1975)
R.	*In re Rouffett,* 149 F.3d 1350, 1357
S.	*KSR International Co. v. Teleflex Inc, et al.,* 127 S. Ct. 1727 (2007)
T.	*Medichem S.A. v. Rolabo, S.L.,* 437 F.3d 1157, 1165 (Fed. Cir 2006)
U.	*Sakraida v. AGPro, Inc.,* 425 U.S. 273 (1976)
V.	*United States v. Adams,* 383 U.S. 39, 40 (1966)

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